Supreme Court, U.S.
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No. ——

In The Supreme Court of the United States

October Term, 1998

Gilbert P. Hyatt,
Petitioner,

v.

Gary W. Boone,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Section 112, ¶ 1 of Title 35 of the United States Code provides, in relevant part, as follows:

> The specification [in a patent application] shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . .

The Question Presented in this case is:

Whether Section 112, ¶ 1 requires a patent applicant to submit a written description of his invention that, in addition to enabling one skilled in the art to make and use the invention, "necessarily" shows "possession" of the invention.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Gilbert P. Hyatt respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-17a) is reported at 146 F.3d 1348. The opinions of the Board of Patent Appeals and Interferences (Pet. App. 22a-58a) are unreported.

JURISDICTION

The judgment of the court of appeals was entered on June 17, 1998. A timely petition for rehearing was denied on August 26, 1998. Pet. App. 20a. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISION INVOLVED

Section 112, ¶ 1 of Title 35 of the United States Code provides as follows:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

STATEMENT

I. This case, like the recent decision in *Pfaff v. Wells Electronics, Inc.*, No. 97-1130, decided November 10, 1998, involves the statutory standards for establishing when an "invention" is complete for purposes of patentability. When patent claims have been altered during the course of proceedings before the Patent and Trademark Office (PTO)—whether through amendment of claims (35 U.S.C. § 132) or through the filing of a continuing application (35 U.S.C. § 120)—it is critical to determine whether such claims are supported by adequate disclosure in both the current application and any prior application for which the benefit of a prior filing date is sought. This case concerns the standards the Federal Circuit has adopted, and now made more stringent, to address that issue. As the petition contends, those standards, like the long-followed "reduction-to-practice" and "substantial completion" standards rejected in *Pfaff*, improperly add to the requirements found in the statute and lead to shifting and inconsistent tests for establishing the right to obtain a patent.

In particular, this case involves the Federal Circuit's standards for the adequacy of the "written description" that a patent applicant must provide, under 35 U.S.C. § 112, ¶ 1, to support the patent claims. The petition

asks the Court to review whether Section 112, ¶ 1 mandates that the application satisfy a "written description" requirement over and above the written description sufficient to enable the making and using of the claimed invention and, if so, what the content of that additional requirement should be. Following its controversial precedents interpreting Section 112, the Federal Circuit below reiterated that the application must meet a separate written description requirement by showing that the inventor was "in possession of" a later-claimed invention. Pet. App. 5a. The court then went on to announce a new strict standard for making that showing, declaring that the written description must be "unambiguous[]": the elements of the patent claim must be either explicit or "*necessarily* comprehended in the description provided," as "understood at the time the patent application was filed." Pet. App. 10a (emphasis added). As we discuss, *see* pages 11-25 *infra*, neither the "possession of the invention" requirement itself, nor the stringent test set forth for applying it, finds any basis in Section 112, which, instead, is satisfied as long as the description enables the making and using of the invention.

A. The issues here arise out of an interference proceeding in the Patent and Trademark Office to determine priority of invention.[1] The invention in question is a computer formed on a single integrated circuit chip, having specified circuits and functions. More particularly, the invention is as follows:

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[1] "The purpose of an interference proceeding is to resolve the question of priority of invention when more than one applicant seeks a patent on substantially the same invention." D. Chisum, 3 *Patents* § 10.09[1][a] at 10-284 (1998 ed.); *see* 35 U.S.C. § 135. The Board of Patent Appeals and Interferences (the "Board") determines "who was first to invent the common subject matter claimed in two or more applications or in one or more applications and an issued patent." *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 1248-49 (Fed. Cir. 1993).

A computer on a chip comprising:

an integrated circuit chip having a computer implemented thereon;

(i) an integrated circuit main memory storing computer instructions, wherein said integrated circuit main memory is included on said integrated circuit chip;

(ii) an integrated circuit operand memory storing operands, wherein said integrated circuit operand memory is included on said integrated circuit chip; and

(iii) an integrated circuit processing circuit processing the operands stored by said integrated circuit operand memory in response to the instructions stored by said integrated circuit main memory, wherein said processing circuit is included on said integrated circuit chip.

The Patent and Trademark Office issued Patent No. 4,942,516 (the '516 patent) to petitioner Hyatt for this invention, which is claim 29 of the patent. Respondent Boone then copied that patent claim into his own patent application and asked the patent examiner to declare an interference. *See* note 1 *supra.* In the resulting proceeding both parties then sought to obtain the benefit of earlier-filed patent applications, seeking to establish priority from the date of those applications. *See* 35 U.S.C. § 120 (discussed, *infra,* at page 5).

The critical question, for purposes of the legal issues in this petition, was whether petitioner was entitled to the benefit of the filing date of an application, No. 05/101,881 (the '881 application), filed on December 28, 1970. That date was approximately seven months prior to the date of the earliest application for which respondent was given the benefit, an application filed on July 19, 1971. As we discuss, the Board concluded that petitioner was not entitled to the benefit of the December 28, 1970 filing date and thus was not entitled to be treated as the first inventor. Before turning to that decision, however,

we briefly set forth the statutory framework governing whether, and in what circumstances, inventors are able to claim the benefit of the filing dates of previous patent applications.

B. The statutory provision specifically addressing the issue of obtaining the benefit of prior patent applications is Section 120 of the Patent Act. That section states, in relevant part, that "[a]n application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States . . . by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application . . . ." To satisfy the conditions of Section 120, therefore, an applicant must meet the requirements of "the first paragraph of section 112."

Section 112, as a whole, sets forth the prescribed contents of the patent specification (required by 35 U.S.C. § 111). Paragraph 1 of that section provides that "[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . ." The paragraph further contains what is known as the "best mode" requirement, stating that the specification "shall set forth the best mode contemplated by the inventor of carrying out his invention." [2]

The Federal Circuit, in construing the "written description" language of Section 112, has held that it contains, in fact, two written description requirements. *See Vas-*

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[2] The decisions of the Board and the Federal Circuit were directed at the first part of paragraph one ("[t]he specification shall contain a written description of the invention" etc.), and it is that language that is addressed in this petition.

Cath, Inc. v. Mahurkar, 935 F.2d 1555 (Fed. Cir. 1991); *In re Alton*, 76 F.3d 1168 (Fed. Cir. 1996). Thus, in its view, it is not enough that the specification contain a written description sufficient to enable the making and using of the invention and set forth the best mode for carrying it out. *See Vas-Cath*, 935 F.2d at 1563-64. Rather, the court has declared that "35 U.S.C. § 112, first paragraph, requires a 'written description of the invention' which is separate and distinct from the enablement requirement." *Id.* According to the court, "the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was *in possession of the invention*." *Id.* (emphasis added).[3]

C. The Board in this case found that the specification in Hyatt's '881 application had not satisfied this second written description requirement. As a result, it found that, under Section 120, which expressly requires compliance with the first paragraph of Section 112, petitioner was not entitled to an effective filing date of December 28, 1970.

1. In making its findings, the Board rejected the argument that original Claim 40[4] in the '881 application, when read together with the disclosure in the body of the

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[3] The Federal Circuit has not limited this doctrine to cases involving Section 120. For example, the court has also held that a patent applicant adding amended claims to an original application, as provided for in 35 U.S.C. § 132, must demonstrate—in addition to enablement—"possession" of the invention defined in the amended claim as of the date of the initial filing. *See Texas Instruments, Inc. v. United States Int'l Trade Comm'n*, 871 F.2d 1054, 1062 (Fed. Cir. 1989); *see also In re Rasmussen*, 650 F.2d 1212, 1214-15 (CCPA 1981).

[4] Paragraph two of Section 112 provides that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2.

specification, fully disclosed the "[c]omputer on a chip" that was claimed in the '516 patent (and then became the subject of the interference count).[5] Original Claim 40 explicitly set forth, as the subject matter of the invention, "[a]n electronic data processing system including read only memory means, alterable memory means and program means, said system being implemented on a single integrated circuit chip." The body of the specification, moreover, set forth in detail the workings of a data processing system that included two memories—an integrated circuit read only memory that stores computer instructions, and an integrated circuit alterable scratch pad memory that stores operands[6]—as well as an integrated circuit data processor. That data processor processed operands stored in the alterable scratch pad memory in response to instructions stored in the read only memory.

The data processing system disclosed in the body of the '881 application had various novel features allowing for implementation on a single chip. Prior art systems were typically either large, expensive, "general purpose" computers that could perform a variety of tasks or smaller, less expensive, "special purpose" machines that were dedicated to specific tasks (Background of the Invention, A201-03).[7] The data processing system described in the '881 application was different: it was a general purpose computer, yet small and inexpensive enough to be dedicated to a specific task. (Summary of the Invention, A204-06).

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[5] A count defines the interfering subject matter (*i.e.*, the invention in dispute) in an interference proceeding. *See* 37 C.F.R. § 1.601(f). The single count in this case was copied exactly from Claim 29 of the Hyatt '516 patent, a claim that was written by Hyatt to describe the data processing system disclosed in the original '881 application.

[6] Operands are simply data that are operated upon.

[7] "A" refers to the Appendix filed in the court of appeals.

The basic design of the data processor, unlike most computers in the prior art, permitted the system to use an integrated circuit memory in place of a "core memory." [8] This change allowed for creation of a completely integrated circuit computer, a "monolithic computer," one that was capable of being implemented on one or more integrated circuit chips. (A210:13-19). Furthermore, unlike prior art computers, the data processor had a simple design of less than 500 logic gates (a measure of the number of electronic circuits), had limited memory requirements, had no minimum clock speed, and had a low pinout (number of wires to or from the chip). *See* A1166-67, A552-53, A649-53, A1171-77. This design permitted the system to be implemented on a *single* integrated circuit chip.

Before he filed the '881 application, petitioner completed the design of his data processing system and built prototypes using commercially available integrated circuit chips. (A516). Petitioner also talked with representatives of several chip manufacturing companies, including Texas Instruments, Intel, and General Instruments, regarding the building of a single chip computer. All of them indicated that they could implement the computer on a single integrated circuit chip. (A516-17).

2. The Board nevertheless held that petitioner had failed to meet the second written description requirement: that is, that he had failed to demonstrate "possession" of the invention as of December 28, 1970. According to the Board, a written description must be held insufficient unless, "when considered in its entirety . . . the *necessary and only reasonable construction* to be given the disclosure by one skilled in the art is one which will lend clear support to each positive limitation in the count."

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[8] A core memory was a magnetic memory using tiny doughnut shaped "cores" strung on wires to store information. As such, it could not be implemented on a single integrated circuit chip.

Pet. App. 34a (emphasis added).[9] Applying that standard, the Board held that petitioner was not entitled to the benefit of the filing date of the '881 application.

The Board acknowledged that original Claim 40 expressly claimed a data processing system "to be implemented on a single integrated circuit chip." It nevertheless decided that the data processing system disclosed in the application did not necessarily correspond to the data processing system described in the ultimately-issued patent and the interference count. The Board reasoned that "the read only memory means of claim 40 *need not* be a main memory storing computer instructions" (Pet. App. 33a) (emphasis added) and, similarly, that "the alterable memory means *need not* be an operand memory storing operands." Pet. App. 33a (emphasis added). The Board then went on to find that the "program means" in Claim 40 was not a processing circuit, Pet. App. 33a, rejecting contrary testimony—*i.e.*, that a person skilled in the art would have understood that the term "program means" referred to a processing circuit—on the ground that the testimony failed to "address[] whether a data processing system must *necessarily* include the specific processing circuit required by the ['516 patent and, hence, the interference] count." Pet. App. 34a (emphasis added).[10]

II. The court of appeals affirmed. It recognized that, under Section 120, petitioner was entitled to the benefit of the filing date of the '881 application provided that

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[9] A "limitation" is terminology that narrows or limits a patent claim or interference count.

[10] The Board did not decide whether the '881 application "enabled" skilled persons to make and use the invention, ruling only that petitioner had not been estopped by an earlier decision, *In re Hyatt*, No. 87-1597 (Fed. Cir. June 9, 1988) (unpublished opinion), from establishing enablement before the PTO. Subsequent to the 1988 decision, petitioner submitted additional evidence regarding enablement to the PTO, ultimately overcoming any objection on grounds of enablement and obtaining the '516 patent.

the application met the statutory requirements of Section 112, ¶ 1. Adhering to circuit precedent, however, it continued to declare that Section 112, ¶ 1 contained (in addition to the best-mode requirement) a two-part burden for inventors to meet. According to the court, "[t]he earlier application must contain a written description of the subject matter of the interference count *and* must meet the enablement requirement." Pet. App. 5a (citing *Fiers v. Revel*, 984 F.2d 1164, 1170 (Fed. Cir. 1993) (emphasis added)).

As it had in the past, the Federal Circuit stated that, to satisfy its separate "written description" requirement, an inventor had to demonstrate that he was in "possession" of the invention at the claimed filing date. Pet. App. 7a-8a (patent application "must describe the subject matter of the count in terms that establish that he was in possession of the later-claimed invention, including all of the elements and limitations presented in the count, at the time of the earlier filing"). The court then went on to address what standard that showing of "possession" had to meet. Like the Board, the court made clear that the standard was a demanding one, stating that, "when an explicit limitation in an interference count is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description *requires* that limitation." Pet. App. 8a (emphasis added). *See also* Pet. App. 8a (quoting *Martin v. Mayer*, 823 F.2d 500, 505 (Fed. Cir. 1987) ("question [is] whether the application *necessarily* discloses that particular device") (emphasis added)). The court thus declared insufficient any specification "that does not *unambiguously* describe all limitations of the count." Pet. App. 8a (emphasis added).

The court of appeals turned aside arguments that this heavy burden was inconsistent with proper standards under Section 112. The court agreed that Federal Circuit

cases had previously used various phrases to describe the burden needed to satisfy the "possession" test—including some that, by their terms, seemed to require less certainty than the " 'necessary and only reasonable construction' " standard applied by the Board—but declared that, in the end, it did "not view these various expressions as setting divergent standards for compliance with § 112." Pet. App. 10a. The court then announced what it saw as the governing standard: "[T]he written description must include all of the limitations of the interference count, or the applicant must show that any absent text is *necessarily* comprehended in the description provided and would have been so understood at the time the patent application was filed." Pet. App. 10a (emphasis added). Following this test—that a written description does not convey possession of the invention unless it explicitly or necessarily does so—the court of appeals held that "[t]he Board did not clearly err in finding that Hyatt did not establish in the '881 application's written description that he possessed the entire subject matter of the count." Pet. App. 10a.

REASONS FOR GRANTING THE WRIT

The issues in this case arise out of the Federal Circuit's serious misreading of Section 112, ¶ 1 of the Patent Act, a critical statutory provision for determining whether an inventor is entitled to a patent for his invention. That section states, in relevant part, that "[t]he specification [in a patent application] shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . ." 35 U.S.C. § 112, ¶ 1.[11]

[11] As noted above, *see* pages 4-6 *supra*, the issue arises in this particular case because of the interplay between Section 112 and Section 120, which states that "[a]n application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the

This language could hardly be clearer: a patent applicant, in order to satisfy the written description requirement of Section 112, ¶ 1, must simply submit a written description of his invention that is sufficient to allow a skilled artisan to make and use that invention.

Notwithstanding this commendable clarity, the Federal Circuit has arrived at two striking determinations. First, it has announced—in the face of wording seeming to say just the opposite—that, to meet the terms of Section 112, it is *not* enough for an inventor to provide a written description "in such full, clear, concise, and exact terms as to enable" the making and using of the invention. Rather, in its view, a written description must also show, in words not found anywhere in the statute, that the inventor was "in possession of" the invention at the time of filing. *See* Pet. App. 5a; *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991). Second, the court has held that its non-statutory standard can be met only by demonstrating that the claimed invention was either explicitly or "necessarily" comprehended in the prior written description. Under that standard, a written description is insufficient even though one skilled in the art would recognize that the specification—giving it a reasonable (though not the only possible) reading—adequately disclosed the subject matter of the invention.

These additional, ever-increasing hurdles for patent applicants simply cannot be squared with the statutory provisions enacted by Congress. *See Pfaff v. Wells Electronics, Inc.*, No. 97-1130, decided November 10, 1998, slip op. at 7 (rejecting judicially-created standard with "no basis in the text" of relevant statutory provision). Nothing in Section 112, ¶ 1 requires a showing—on top of a showing sufficient to enable the making and using of the invention—that the inventor was "in possession of"

United States . . . shall have the same effect, as to such invention, as though filed on the date of the prior application . . . ." 35 U.S.C. § 120.

the invention, much less that he or she was "necessarily" in possession of it. Indeed, this Court in *Pfaff* has recently made clear that proof of enablement *by itself* is sufficient to demonstrate that an invention has been fully conceived and is "ready for patenting," slip op. at 11-13, a determination that would seem to inform the proper construction of Section 112, ¶ 1 as well. Furthermore, as critics have rightly observed, the possession-of-the-invention requirement leads to a largely standardless inquiry, producing a series of *ad hoc* judgments without any coherent rhyme or reason. It thus presents a formidable, yet indistinct, barrier to inventors seeking to comply with the filing requirements of the Patent Act.

The proper construction of Section 112 is a matter of considerable importance to the sound working of the patent system. Although the Federal Circuit has made clear that its additional requirement is of significance only for amended claims, *see* pages 22-25 *infra*, it is common practice for patent applicants to file successive applications, or otherwise to amend their claims, during the course of proceedings before the Patent and Trademark Office, and the right to obtain a patent thus will often turn on what support Section 112 requires for such claims. According to Federal Circuit doctrine, however, an application will not support a claim unless the application contains—in addition to an enabling description—a description "necessarily" showing "possession" of the invention, despite the fact that an enabling description alone is enough to show that an invention is complete (and to start the clock running against an applicant) for purposes of other statutory provisions. *See Pfaff*, slip op. at 11-13. This extra-statutory condition not only will wrongfully deny patents to applicants relying on otherwise complete applications but will create a needless burden on future applicants seeking to draft specifications to anticipate what the Federal Circuit might someday deem enough to show "possession" of a later-claimed invention. This judicial recasting of the

patent system should not be allowed to proceed without review by this Court.

I. A. The decision of the Federal Circuit in this case has further tilted the balance against inventors seeking to obtain patent protection, holding that their applications will not satisfy the written description requirement of Section 112 unless they expressly or "necessarily" encompass the subject matter of the claimed invention. As we discuss below, *see* pages 19-22 *infra*, that standard, even viewed in isolation, calls for a degree of certainty that is wholly out-of-place in the prosecution of patent applications. What makes the standard even worse, however, is that it increases the difficulty of meeting a requirement—the possession-of-the-invention requirement—that is not in Section 112 in the first place. Thus, as the burdens imposed on patent applicants mount, the scheme created and enforced by the Federal Circuit bears less and less relationship to the statutory scheme enacted by Congress.[12]

The central point of demarcation is a relatively recent series of decisions by the Federal Circuit (and its predecessor, the Court of Customs and Patent Appeals) announcing that Section 112, ¶ 1 contains a written description requirement *in addition to* the familiar requirement that a patent specification contain a description sufficient to enable the making and using of the invention at issue.

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[12] The new written description requirement devised by the Federal Circuit only affects the patentabiilty of *amended* claims. *See* D. Chisum 3 *Patents* § 7.04 at 7-137 (1998 ed.) ("[t]he description requirement comes into play when a claim is added by an applicant for a patent at some stage after the original filing date and the claim differs in scope from the original claims"). By contrast, it is always the case that "an 'original claim,' that is, one contained in a patent specification when it is filed, complies with the Section 112 invention description requirement." D. Chisum, 3 *Patents* § 704[1][c] at 7-152 (1998 ed.). That is because "original claims constitute their own description," *In re Koller*, 613 F.2d 819, 823-24 (CCPA 1980), and thus by definition show "possession" of the invention they describe. *See* pages 22-25 *infra*.

See, e.g., Vas-Cath, 935 F.2d at 1555; *In re Barker*, 559 F.2d 588 (CCPA 1977), *cert. denied*, 434 U.S. 1064 (1978); *In re Ruschig*, 379 F.2d 990 (CCPA 1967). As one commentator has observed, "[t]he notion of the *description* requirement as separate and distinct from the *enablement* requirement of 35 USC 112 may be analogized to a UFO, first identified in 1967, fifteen years after launch and confirmed by the early 1970s." Pitlick, *Looking Beyond Blazemarks on Trees—It's Time To Revisit the Description Requirement in the Wake of Warner-Jenkinson*, 79 J. Pat. & Trademark Off. Soc'y 625, 628-29 (1997). Although the Federal Circuit appeared for a time to be backing away from its idea of a second written description requirement, *see Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F.2d 1419, 1421 (Fed. Cir. 1987), *cert. denied*, 486 U.S. 1008 (1988) ("[t]he purpose of the description requirement of this paragraph is to state what is needed to fulfill the enablement criteria"), it now appears that, insofar as the Federal Circuit is concerned, the requirement is here to stay. A few years ago, the Court in *Vas-Cath* expressly sought to eliminate "some confusion in our decisions" (935 F.2d at 1563) by reaffirming "that 35 U.S.C. 112, first paragraph, requires a 'written description of the invention' which is separate and distinct from the enablement requirement." 935 F.2d at 1563. This novel requirement—"born in mysterious circumstances, abused during its adolescence, and now a wayward adult" (Rhoades, *The Section 112 "Description Requirement"—A Misbegotten Provision Confirmed*, 74 J. Pat. & Trademark Off. Soc'y 869, 902 (1992)—thus will continue to serve as an obstacle to patent applicants otherwise in compliance with the requirements of Section 112.

Given that the various Patent Acts have contained a written description requirement for more than 200 years, it is not surprising that the belated discovery of a second "separate and distinct" requirement has engendered considerable skepticism. *See* R. Merges, *PATENT LAW & POLICY* 713 (2d ed. 1997) ("[t]here has been dispute

concerning the written description requirement since its refinement and reemergence in the CCPA"). Although the Federal Circuit insists that Section 112 calls for a description showing that the inventor was "in possession of the invention," *Vas-Cath*, 935 F.2d 1564, the language of Section 112, ¶ 1 gives no hint of the need for any such showing. Naturally read, the relevant part of paragraph one calls for nothing more than a written description "in such full, clear, concise, and exact terms as to enable" the making and using of the invention. *See Wood v. Underhill*, 46 U.S. (5 How.) 1, 5 (1847) (description must be "so full, clear, and exact as to enable any one skilled in the art to compound and use it"); *Beidler v. United States*, 253 U.S. 447, 453 (1920) (same); *Smith v. Snow*, 294 U.S. 1 (1935) (same). Indeed, the contrary view adopted by the Federal Circuit is derived only by reading into the statute a grammatical absurdity: that the subsequent words "in such full, clear, concise, and exact terms as to enable" do not modify the phrase "a written description of the invention" at all, but relate solely to the *parenthetical* phrase "and of the manner and process of making and using it." As a matter of statutory construction, therefore, the requirement created by the Federal Circuit runs head-on into the plain meaning of the crucial language.

The statutory history of Section 112, likewise, belies any notion that it requires a separate showing of "possession" of the claimed invention. It is true that an earlier version of Section 112 once contemplated that the written description of the invention would serve two distinct purposes. Thus, the 1793 Patent Act provided that an inventor must "deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms" as, *first*, "to distinguish the same from all other things before known" and, *second*, "to enable any person skilled in the art or science, of which it is a branch, or with which it is most nearly connected, to make, compound,

and use the same." Patent Act of 1793, Sec. 3. *See also Evans v. Eaton*, 20 U.S. (7 Wheat.) 356 (1822). But this historical evidence of dual purposes offers no support for the requirement now recognized by the Federal Circuit. Quite apart from the fact that the language was dropped from the statute in 1836, and has not been revived,[13] the additional purpose contemplated by the 1793 Act ("distinguish[ing] the same from all other things before known") had nothing whatsoever to do with the idea of demonstrating "possession" of the invention. Thus, whether one looks at the language of Section 112 or its historical pedigree, it remains apparent that the Federal Circuit, following the lead of the Court of Customs and Patent Appeals, has fashioned its new requirement out of thin air. *See Pfaff*, slip op. at 7 (rejecting court of appeals' standard "with no basis in the text").

Its uncertain statutory moorings aside, *see* Rhoades, *supra*, at 870-73, the separate written description requirement has been subjected to a number of other telling criticisms. Most colorfully, Judge Markey, "heartily" dissenting in *In re Barker*, noted the peculiarity of deciding that an inventor who has enabled others to make and use his invention is somehow not himself in possession of that same invention, stating: "How incongruous. How exaltive of form over substance." 559 F.2d at 594.[14] That

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[13] The function of distinguishing the invention from "things before known" is now fulfilled by the language of the claims. The 1836 Act was the first patent statute to require the inventor to specify the subject matter of the invention. *See* D. Chisum, 3 *Patents* § 8.02[2] at 8-7 (1998 ed.). The 1870 Act subsequently incorporated a requirement that the inventor "claim" his invention. *Id. See Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384, 1390 (1996).

[14] Judge Markey pointedly noted that "disclos[ing] an invention in such 'clear, concise and exact terms' (enablement) as to enable its practice [was] the very purpose and quid pro quo of the patent system from its inception." 559 F.2d at 594. *See also* Merges, *supra*, at 714 (pointing out that "the regular enablement requirement seeks to relate patent scope to the underlying value of the patentee's disclosure").

counter-intuitive notion might make sense, perhaps, if an inventor could satisfy the enablement requirement with merely a bare-bones description, forcing skilled artisans to go to extraordinary lengths to make and use the invention; but it is well established that the enablement requirement is not met if one skilled in the art has to resort to undue experimentation. *See* D. Chisum, 3 *Patents* § 7.03 at 7-10 (1998 ed.); *Minerals Separation v. Hyde*, 242 U.S. 261 (1916). The Federal Circuit has thus created an illogical body of law under which persons of ordinary skill are deemed able to make and use the invention without undue effort but the inventor, who instructed them how to do so, is nevertheless not entitled to claim that invention as his own.

This Court, by contrast, has just strongly reaffirmed that a written description enabling the making and using of an invention is ample proof that the inventor has sufficiently conceived of it. *See Pfaff*, slip op. at 11-13. In *Pfaff* the Court stressed that "[t]he word 'invention' must refer to a concept that is complete, rather than merely one that is 'substantially complete.'" Slip op. at 11. Noting that "one can prove that an invention is complete and ready for patenting before it has actually been reduced to practice," slip op. at 11, the Court then specifically pointed to a form of proof that would be sufficient: "proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention." Slip op. at 12. But if proof of enablement is enough to show that "an invention is complete and ready for patenting," there is no justification for contriving a further nontextual requirement, over and above that of enablement, to deny the inventor a patent for that invention.

Equally troubling is the fact that the possession-of-the-invention requirement is bereft of any meaningful content. *See* Rhoades, *supra*, at 893 (describing standard as

"unduly vague and 'subjective' "); Pitlick, *supra*, at 635 (noting "difficulty of determining precisely what the inventor *possessed* at the time in question"). This lack of content leads to several distinct, though related, problems. Naturally enough, it leads to decisions, sometimes finding "possession," sometimes not, without any coherent pattern or principle. *See* Rhoades, *supra*, at 870 ("since the 'description requirement' lacks a firm mooring in the language of the statute or its underlying purposes, many of the decisions applying the requirement seem unprincipled or misguided"); Walterscheid, *Insufficient Disclosure Rejections (Part III)*, 62 J. Pat. Off. Soc'y 261, 282 (1980) ("whether there is adequate description of the invention is frequently more subjective than the C.C.P.A. would care to admit"). That incoherency, in turn, puts inventors in the awkward position of trying to draft, or defend, patent applications to meet an essentially amorphous test. These difficulties all arise inevitably from the need to apply a rootless standard "that requires disclosure beyond that of the ordinary enablement requirement of § 112, and yet short of a requirement of actual claiming." Merges, *supra*, at 714.[15]

B. The decision below aggravates the problems provoked by a free-floating "possession" requirement by holding, in essence, that all doubts about possession are to be resolved against the inventor. Although the court of appeals paid lip service to the straightforward test urged by petitioner—whether the disclosure "reasonably conveys to the artisan" that the inventor had possession of the subject matter, *see* Pet. App. 10a—it effectively read the word "reasonably" out of that test, substituting instead a strict standard for determining whether possession had been conveyed: "[T]he written description must include all of the limitations of the interference count, or the ap-

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[15] Even the Federal Circuit has conceded that "the precedential value of cases in this area is extremely limited." *Vas-Cath*, 935 F.2d at 1562 (quoting *In re Driscoll*, 562 F.2d 1245, 1250 (CCPA 1977)).

plicant must show that any absent text is *necessarily* comprehended in the description provided and would have been so understood at the time the patent application was filed." Pet. App. 10a (emphasis added). This standard was fully in keeping with the earlier admonition by the court that a description must "unambiguously describe[] all the limitations of the count." Pet. App. 8a. The court thus was able to uphold the Board finding that petitioner had not demonstrated possession of his invention.[16]

The new standard adopted by the Federal Circuit, like the possession-of-the-invention requirement itself, finds no apparent basis in the language of Section 112. The only possibly applicable language—that the written description be in "full, clear, concise, and exact terms"—relates, of course, specifically to the requirement that the description enable the making and using of the invention, a part of paragraph one that the Federal Circuit regards as separate and distinct from the "possession" requirement. Even if that language were borrowed, however, it would not support the notion that a written description must unambiguously or necessarily show possession of the invention. In the context of enablement, the words "in full, clear, concise, and exact terms" do *not* mandate a description that "necessarily" or "unambiguously" leads to the making and using of the invention. Instead, it is sufficient that one skilled in the art, applying his knowledge, can make and use the invention without undue trial and error. *See* page 18 *supra*.

A comparable standard should apply here. Although a written description may be susceptible to several imaginable readings, there is no good reason—at least, the Federal Circuit has offered none—to resolve all doubts against

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[16] Although the court did not disavow the language relied on by petitioner, it nevertheless held that a written description, by law, could not convey possession unless it met the newly-announced standard. Pet. App. 10a. It then affirmed the decision of the Board, which had held that the description had to meet a strict "necessary and only reasonable construction" standard. Pet. App. 34a.

the inventor. On the contrary, if a second written description requirement is to be applied at all, it seems most natural to inquire whether, applying normal burdens of proof, the description reasonably conveys to one skilled in the art that the inventor was in possession of the invention at the relevant time. *See Minerals Separation v. Hyde*, 242 U.S. at 270 ("the certainty which the law requires in patents is not greater than is reasonable, having regard to their subject matter"). So long as that standard is met, then the written description has satisfied the vital purpose of apprising the public of "new and useful advances in technology." *Pfaff*, slip op. at 8. The fact that the description might possibly be read to convey other inventions as well does not mean that the inventor has failed to make adequate disclosure of his claimed invention.

The mischief worked by refusing to read the written description in a reasonable light can be readily seen in this case. The Board acknowledged that original Claim 40 in the '881 application—on its face, highly similar to the count at issue in the interference proceeding—*might* describe a data processing system with two memories and a processing circuit, all "implemented on a single integrated circuit chip." Pet. App. 33a. Applying its "necessary and only reasonable construction" standard, however, it went on to find that "the read only memory means of claim 40 *need not* be a main memory storing computer instructions and the alterable memory means *need not* be an operand memory storing operands." Pet. App. 33a (emphasis added). By the same token, it found that the "program means" in original Claim 40 was not the processing circuit of the count, saying that contrary testimony (that those skilled in the art would recognize that the term referred to a processing circuit) had failed to address "whether a data processing system must necessarily include the specific processing circuit required by the count." Pet. App. 34a; *see also* Pet. App. 34a ("[t]he 'program means' as an alleged processing circuit *does not*

have to operate on operands stored in an on-chip memory") (emphasis added) Even if those speculative readings were plausible—a doubtful proposition because, among other things, they construe the claim as involving a data processing system without a data processor—they do little to answer the proper question: whether the claim language and the body of the specification, considered together, would disclose the invention to one skilled in the art.

Like burdens of proof, *see generally Addington v. Texas*, 441 U.S. 418, 423 (1979), the standard chosen for assessing written descriptions ultimately allocates where the risk of particular determinations must lie. By resolving any ambiguity against an inventor, the Federal Circuit has apparently decided that it is sound policy to deny patents to inventors whose applications likely, but not necessarily, comprehend the subject matter of their claims. But the basis for this choice is unstated, and, given efforts by Congress to stimulate inventive activity, the basis for the choice is hardly clear. In our view, even assuming that a distinct possession-of-the-invention requirement exists at all, it is far more consistent with the requirements of Section 112 in particular, and with the objectives of the Patent Act as a whole, to award the benefits of patent protection to an inventor as long as the submitted written description, reasonably read, disclosed the invention to those skilled in the art at that time.

C. The Federal Circuit has indicated that its separate written description requirement is intended to protect against "overreaching" by inventors filing amended claims. *See Vas-Cath*, 935 F.2d at 1561 (quoting *Rengo Co. Ltd. v. Molins Mach Co.*, 657 F.2d 535, 551 (3d Cir.), *cert. denied*, 454 U.S. 1055 (1981) ("possession" requirement " 'guards against the inventor's overreaching by insisting that he recount his invention in such detail that his *future* claims can be determined to be encompassed

within his original creation.' ") (emphasis added)). *See also In re Smith*, 481 F.2d 910, 914 (CCPA 1973); *In re Wright*, 866 F.2d 422 (Fed. Cir. 1989). But there are several obvious problems with this attempted rationale. To begin with, it simply does not fit with the language and structure of Section 112, which gives no indication of a legislative concern about, or hostility to, amended claims. Rather, the requirements expressly set forth in Section 112 (the enablement and best mode requirements) apply in equal measure to all claims, amended or not. It is thus quite wrong to read Section 112 as embodying an on-again, off-again requirement that, at bottom, makes the right to obtain a patent depend on whether the claimed invention is defined in an original or an amended claim.[17]

The disfavored treatment given to amended claims is out-of-place for another reason as well. Whether or not concerns about amendment of claims are well-founded, *see, e.g.*, Marcus, *Is the Submarine Patent Torpedoed?: Ford Motor Co. v. Lemelson and the Revival of Continuation Application Laches*, 70 Temple L. Rev. 521, 524-27 (1997),[18] the fact remains that the right to alter the originally filed claims—without loss of the original filing

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[17] The Court of Customs and Patent Appeals has described several circumstances in which the requirement is implicated, stating that "[t]his concept applies whether the case factually arises out of an assertion of entitlement to the filing date of a previously filed application under § 120 . . . or arises in the interference context wherein the issue is support for a count in the specification of one or more of the parties . . . or arises in an ex parte case involving a single application, but where the claim at issue was filed subsequent to the filing of the application." *In re Smith*, 481 F.2d at 914.

[18] *But see* Marcus, *supra*, at 583 ("[*State Industries, Inc. v. A.O. Smith Corp.*, 751 F.2d 1226 (Fed. Cir. 1985)] announced that there is nothing improper or illegal about one competitor attempting to exclude another's product from the market when that product is merely an embodiment of the invention disclosed but unclaimed in its pending patent application").

date—is provided for in the Act. Section 120, by its express terms, allows for the filing of more than one application, with later applications entitled to the filing date of earlier ones so long as they meet the stated conditions (including compliance with the first paragraph of section 112). Likewise, Section 132, addressing rejection of (or objections to) patent claims, contemplates that an applicant may amend his application, so long as he does not "introduce new matter into the disclosure of the invention." Against this background, the Federal Circuit lacks the authority to impose additional conditions on the rights extended by Congress, either by announcing extra-statutory conditions as such or, as here, by reading into the statute conditions that are not there. *See Pfaff*, slip op. at 8 (rejecting "nontextual argument").[19]

The burdens added by the Federal Circuit are even more inappropriate because Congress itself has given substantial recent attention to issues arising out of prolonged patent prosecutions, including the amendment of claims. Most notably, Congress has decided that patents issued on applications filed on or after June 8, 1995 will have a life of 20 years, *less* the time that applications for the patents were in prosecution. *See* 35 U.S.C. § 154 (West Supp. 1995). That modification has been criticized as inadequate to eliminate all difficulties caused by amendment of claims, *see* Marcus, *supra*, at 525-26, but it clearly shows that Congress is able to address for itself any perceived malfunctions in the patenting process. If Congress believes that the provisions allowing for amendments to patent applications are too lenient in some way, it can elect to amend Sections 120 and 132, or, for that matter,

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[19] Professor Chisum has noted that the Federal Circuit appears to be using the possession-of-the-invention requirement to serve some of the purposes once served by the also non-statutory, and now largely abandoned, "late claiming" doctrine. D. Chisum, 4 *Patents* § 11.05 at 11-260 (1998 ed.). *See Muncie Gear Works, Inc. v. Outboard, Marine & Mfg. Co.*, 315 U.S. 759 (1942).

amend Section 112 to include additional requirements. To date, however, it has not done so.

Finally, even leaving aside questions of authority, it is simply not clear why Section 112 as written—that is, prior to judicial discovery of a separate possession-of-the-invention requirement—was inadequate to deal with any "overreaching" arising out of the amendment of claims. By any reading, Section 112 already mandates that the original written description be in such "full, clear, concise, and exact terms as to enable" the making and using of the invention defined in the claims at issue (including, of course, the invention defined in any amended claim). Provided that the written description satisfies *that* requirement, what is the objection to recognizing that the inventor has a valid claim to the subject invention? As one commentator has stated, "[a] description of the invention, and the manner of using it, in terms sufficient to enable the artisan to make and use it, provides strong evidence that the inventor has fully grasped, and is therefore entitled to claim as his or her own invention, the subject matter claimed." Rhoades, *supra*, at 897. Indeed, the idea that enablement is *not* enough seems flatly contrary to the view just expressed by this Court, in a related context, that an invention is complete and "ready for patenting" when the inventor provides a description that is "sufficiently specific to enable a person skilled in the art to practice the invention." *Pfaff*, slip op. at 12.

II. The issues in this case are of substantial importance to the proper administration of the Patent Act. Most patent applications involve amendments to the claims, and it is often necessary to determine what filing date should be accorded to the amended claims.[20] Yet,

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[20] As Professor Chisum has stated: "[t]he filing date of an application for a patent is critical because of the statutory bar provisions . . . . It is also the prima facie invention date for determining novelty, priority, and nonobviousness." D. Chisum, 3 *Patents* § 7.04 n.6, at 7-137 (1998 ed.).

as a result of the extra-statutory doctrine crafted by the Federal Circuit, a patent applicant faces a strange contradiction: although this Court regards an enabling description as sufficient in and of itself to show that an invention is "complete and ready for patenting," *see Pfaff*, slip op. at 11-13, the Federal Circuit regards an enabling description as *in*sufficient to show "possession" of the invention at the time of description. Not only is this dissonance illogical—how can an inventor have a complete concept of his invention and yet not be in possession of it?—but it produces dual standards when a single standard for marking the time of complete invention would be both clearer and more fair.

The obstacles created by the Federal Circuit also have serious practical repercussions for patent applicants. Most particularly, applicants like petitioner, who are relying on previously filed applications, will be denied patents to which they would be entitled under the statute as Congress seemingly has written it. This case provides a stark example: although a person skilled in the art (using the disclosure in the '881 application) could make and use a data processing system implemented on a single chip without any undue experimentation, *see* note 10 *supra*, and although this skilled person would reasonably conclude that petitioner himself had possession of that invention at the time, the cumulative standards developed by the Federal Circuit for applying Section 112 have deprived petitioner of his patent for that invention. And this case is not unusual: the court of appeals maintains the power to bring about such denials in any case in which it decides, after the fact, that an applicant has not shown possession with the certainty now called for by its newly announced test.

The burdens on future patent applicants will also be increased. An inventor or a patent lawyer, undertaking the already difficult task of drafting patent applications, now has the responsibility to draft a specification so free

of ambiguity that, by "necessary construction," Pet. App. 10a, it will be seen to convey possession of an invention to be defined in later, yet-to-be drafted claims.[21] And he or she must undertake that responsibility having been told that a description sufficient to enable the making and using of that invention is not enough, but not having been told what would be enough. The natural effect will be to force the drafting of applications that are increasingly prolix, in an effort to cover all the possible bases on this increasingly-tilted playing field. Indeed, inventors may ultimately become more reluctant to seek patent protection, or expend money on research and development, when patent rights depend on the uncertainty of predicting just what description will later be regarded as sufficient to show possession of a particular invention.

There is, in the end, no sound basis for requiring patent applicants to shoulder these added burdens. The Federal Circuit has impermissibly distorted the statutory scheme enacted by Congress, and review by this Court is warranted.

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[21] The Board in this case did not dispute that the written description in the '881 application could have *included* the invention in issue; rather, it found that the description did not necessarily *exclude* other possible inventions. Pet. App. 33a-35a. It seems an especially onerous task, however, to require an inventor to describe both what he considers to be his invention and what he considers not to be his invention.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1514, -1515
(Interference No. 102,598)

GILBERT P. HYATT,
Appellant,

v.

GARY W. BOONE,
Cross-Appellant.

DECIDED: June 17, 1998

Before NEWMAN, MICHEL, and PLAGER, *Circuit Judges.*

NEWMAN, *Circuit Judge.*

The parties to Patent Interference No. 102,598 are Gilbert P. Hyatt, inventor of United States Patent No. 4,942,516 entitled "Single Chip Integrated Circuit Computer Archiecture" (the '516 patent), and Gary W. Boone, inventor of patent application Serial No. 07/473,541 entitled "Variable Function Programmed Systems" (the '541 application). Mr. Hyatt appeals the decision of the Board of Patent Appeals and Interferences, entering judgment against him and cancelling the relevant claims of his '516 patent. Mr. Boone cross-appeals the Board's entry of

judgment against him. We affirm the Board's decision,[1] with modification of the judgment to declare Boone the prevailing party in the interference.

DISCUSSION

Determination of priority of invention invokes a complex body of procedural and substantive law, applied in the first instance in administrative proceedings in accordance with 35 U.S.C. § 135(a) ("The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability.") The interference proceeding implements the principle of United States law that the right to a patent derives from priority of invention, not priority of patent application filing.

The general rule is that the first person to conceive the invention is the first inventor, *see* Irving Kayton, *The United States Patent as a Legal Instrument, in* 1 *Patent Practice* 2-1, 2-39 (Irving Kayton and Karyl S. Kayton eds., 4th ed. 1989) ("The earliest possible date of invention, therefore, is the date of conception."), provided that when the first to conceive the invention is the last to reduce it to practice, the person who was first to conceive must have exercised reasonable diligence to his own actual or constructive reduction to practice, "from a time prior to conception by the other." 35 U.S.C. § 102(g). *See* Charles L. Gholz, *Interference Practice, in* 6 *Patent Practice, supra,* 24-1, 24-6(c); *Paulik v. Rizkalla,* 760 F.2d 1270, 1272, 226 USPQ 224, 225 (Fed. Cir. 1985) (in banc). Thus, during an interference proceeding evidence may be presented of conception, reduction to practice, and diligence, as appropriate to the positions of the parties, *see id.*; *see generally* Gholz, *supra,* at 24-1, or a party

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[1] *Hyatt v. Boone,* Patent Interference No. 102,598 (Bd. Pat. App. & Inter. Sept. 19, 1995) (Decision after Final Hearing); *Hyatt v. Boone,* Patent Interference No. 102,598 (Bd. Pat. App. & Inter. May 10, 1996) (Decision on Reconsideration).

may rely on the patent document to establish the facts of priority of invention. *See* Gholz, *supra,* at 24-45.

The contested invention is a computer formed on a single integrated circuit chip, having specified circuits and functions. The sole count of the interference is:

> A computer on a chip comprising:
>
> an integrated circuit chip having a computer implemented thereon;
>
> an integrated circuit main memory storing computer instructions, wherein said integrated circuit main memory is included on said integrated circuit chip;
>
> an integrated circuit operand memory storing operands, wherein said integrated circuit operand memory is included on said integrated circuit chip; and
>
> an integrated circuit processing circuit processing the operands stored by said integrated circuit operand memory in response to the instructions stored in said integrated circuit main memory, wherein said processing circuit is included on said integrated circuit chip.

The interference contest was initiated by Boone after Hyatt's '516 patent issued. Boone followed the procedure of copying certain of Hyatt's patent claims into his pending application and asking the patent examiner to "declare" the interference. 37 C.F.R. § 1.607 (1990). The examiner so acted. *See* 37 C.F.R. § 1.611 (1990).

Both parties claimed the benefit of earlier-filed patent applications, relying on the earlier applications for constructive reduction to practice of the subject matter of the count. *See* 37 C.F.R. § 1.626 (1990). Conception is not at issue in this appeal, and neither party presented evidence of actual reduction to practice. At the Motions stage from which the Board's decision evolved, the only

issue was each party's entitlement to certain asserted dates of constructive reduction to practice.

Boone was granted an effective filing date, through a chain of nine prior applications, of an application filed on July 19, 1971. Hyatt was granted an effective filing date, through a chain of four prior applications, of an application filed on December 14, 1977. The Board denied Hyatt the benefit of the filing date of his December 28, 1970 application No. 05/101,881 (the '881 application) as to the subject matter of the count. Hyatt disputes the denial of the '881 application filing date, and also challenges the date awarded to Boone.

I

HYATT'S '881 APPLICATION

The filing of a patent application serves as conception and constructive reduction to practice of the subject matter described in the application. *Yasuko Kawai v. Metlesics*, 480 F.2d 880, 885, 178 USPQ 158, 162 (CCPA 1973) ("[T]he act of filing the United States application has the legal effect of being, constructively at least, a simultaneous conception and reduction to practice of the invention."); *see Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) ("constructive reduction to practice occurs when a patent application on the claimed invention is filed"); *In re Glass*, 492 F.2d 1228, 1232, 181 USPQ 31, 34 (CCPA 1974). There is no need for proof or corroboration of the subject matter that is included in the application unless a date earlier than the filing date is sought to be established. *Yasuko Kawai*, 480 F.2d at 886, 178 USPQ at 163 ("the written specification in the application is the evidence proving the invention of that which is reduced to practice"). Thus the inventor need not provide evidence of either conception or actual reduction to practice when relying on the content of the patent application.

However, the patent application must comply with the legal requirements for support of the interference count. When a party to an interference seeks the benefit of an earlier-filed United States patent application, the earlier application must meet the requirements of 35 U.S.C. § 120 [2] and 35 U.S.C. § 112 ¶ 1 [3] for the subject matter of the count. The earlier application must contain a written description of the subject matter of the interference count, and must meet the enablement requirement. *Fiers v. Revel*, 984 F.2d 1164, 1170, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993) (section 112 paragraph 1 must be met by the earlier application). The Board found that Hyatt's '881 application did not provide the requisite written description; the Board did not decide the question of enablement.

A

We review the Board's findings on the standard of clear error, for compliance with the written description requirement is a question of fact. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). Hyatt relies as written description on the text of claim 40 as that claim was originally filed in the '881 application, viewed with the entire specification.

The claims as filed are part of the specification, and may provide or contribute to compliance with § 112.

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[2] **35 U.S.C. § 120. Benefit of earlier filing date in the United States.**

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States . . . shall have the same effect, as to such invention, as though filed on the date of the prior application . . . .

[3] **35 U.S.C. § 112 ¶ 1.**

[The application must contain] a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . .

See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 938, 15 USPQ2d 1321, 1326 (Fed. Cir. 1990) (the original claims are part of the patent specification); *In re Benno*, 768 F.2d 1340, 1346, 226 USPQ 683, 686-87 (Fed. Cir. 1985); *In re Frey*, 166 F.2d 572, 575, 77 USPQ 116, 119 (CCPA 1948). Hyatt's original claim 40 is for a data processing system implemented on a single integrated circuit chip, as follows:

> 40. An electronic data processing system including read only memory means, alterable memory means and program means, said system being implemented on a single integrated circuit chip.

There is no other mention in the '881 specification of a single integrated circuit chip, although other electronic data systems are extensively described.

Hyatt's position is that the text of claim 40 describes the subject matter of the interference count, in that the "read only memory means" of claim 40 is the same as the "integrated circuit main memory storing computer instructions" of the count, the "alterable memory means" of claim 40 is the same as the "integrated circuit operand memory storing operands" of the count, and the "program means" of claim 40 is the same as the "integrated circuit processing circuit" of the count. Hyatt states that the '881 specification contains detailed descriptions of various computer circuits, which supplement the text of claim 40 in that the specification describes a computer made up of numerous integrated circuits mounted on multiple printed circuit boards and comprising a "physically distributed, operatively dispersed system."

The Board held that the written description must be sufficient, when the entire specification is considered, that the "necessary and only reasonable construction" that would be given it by a person skilled in the art is one that clearly supports each positive limitation in the count. The Board found that the term "program means" in claim 40 is used to describe only computer instructions or as a

modifier of "program control means," and does not describe or require the interpretation that the program processes the operands stored by the alterable memory in accordance with instructions stored in the read only memory, as is required by the count. The Board also found that the "read only memory means" of claim 40 need not be a main memory storing computer instructions, and that the "alterable memory means" of claim 40 need not be an operand memory storing operands. Thus the Board found that original claim 40 could be read as describing subject matter other than that of the count, and thus did not establish that Hyatt was in possession of the invention of the count. The Board found that the parts of the written description that are lacking from claim 40 are not provided elsewhere in the '881 specification, whose systems and circuitry neither describe nor suggest a computer on a single chip. The Board concluded that "[w]hile two memories and a computer program may generally constitute a data processing system of some sort, they do not describe the invention set forth by the count."

Rejecting Hyatt's argument, supported by testimony of witnesses, that the absent description would have been apparent to persons of skill in this field, the Board stated that "if 'program means' can be a circuit (processor) that responds to a program as indicated by [Hyatt's] witnesses, it is at least as likely that it can be a memory that merely stores a program without processing operands." The Board held that witnesses can not "establish facts which the disclosure itself should provide," citing *In re Smyth*, 189 F.2d 982, 990, 90 USPQ 106, 112 (CCPA 1951). Hyatt challenges these findings and conclusions, as well as the Board's legal standard for determining compliance with the written description requirement.

B

For an earlier-filed application to serve as constructive reduction to practice of the subject matter of an interference count, the applicant must describe the subject matter of the count in terms that establish that he was in

possession of the later-claimed invention, including all of the elements and limitations presented in the count, at the time of the earlier filing. Although Hyatt is correct that known details need not be included in a patent specification, *see In re Eltgroth*, 419 F.2d 918, 921, 164 USPQ 221, 223 (CCPA 1970) ("This court has often observed that minutiae of descriptions or procedures perfectly obvious to one of ordinary skill in the art yet unfamiliar to laymen need not be set forth."), when an explicit limitation in an interference count is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation. As discussed in *Martin v. Mayer*, 823 F.2d 500, 505, 3 USPQ2d 1333, 1337 (Fed. Cir. 1987), "It is 'not a question of whether one skilled in the art *might* be able to construct the patentee's device from the teachings of the disclosure . . . . Rather, it is a question whether the application necessarily discloses that particular device.'" (quoting *Jepson v. Coleman*, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963)). *See Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). It is insufficient as written description, for purposes of establishing priority of invention, to provide a specification that does not unambiguously described all limitations of the count. *See, e.g., Wagoner v. Barger*, 463 F.2d 1377, 1380, 175 USPQ2d 85, 86-87 (CCPA 1972); *Dyer v. Field*, 386 F.2d 466, 156 USPQ 85 (CCPA 1967); *Bocciarelli v. Huffman*, 232 F.2d 647, 109 USPQ 385 (CCPA 1956).

Hyatt and Boone presented conflicting views of the knowledge of a person of ordinary skill in the field of the invention at the time the '881 patent application was filed, and disputed whether such a person would have understood the text of Hyatt's original claim 40 as describing all of the limitations of the count. Hyatt's witnesses testified that a person of skill in this field would have known

that the program means processes the operands in accordance with the read-only memory instructions, and would have readily understood that the program means, read only memory means, and alterable memory means cooperate in the way stated in the count. The Board criticized this testimony on the ground that although Hyatt's witnesses stated that it was well known that a data processing system must include a processing circuit of some sort, they did not address "whether a data processing system must necessarily include the specific processing circuit required by the count." We have not been shown clear error in the Board's findings as to the content of the written description, and the conclusion that the missing subject matter was not known details, but significant claim limitations; the missing subject matter was not shown to be part of the prior art that would be understood as part of the description of the subject matter of the count.

Hyatt states that even if the Board's findings are not clearly erroneous as to the content of the written description, the Board applied an incorrect legal standard in requiring that the specification "necessarily" describe the entire subject matter of the count. Hyatt states that a separate body of precedent, typified by *Vas-Cath Inc v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991), states a different and better standard. In *Vas-Cath* the court stated that the applicant must "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Id.* at 1563-64, 19 USPQ2d at 1117. Other cases have used the same words in assessing the adequacy of the written description. *See, e.g., Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996) ("the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question"); *Fiers v. Revel*, 984 F.2d at 1170, 25 USPQ2d at 1606 (same);

In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (same). Hyatt states that he readily met this requirement, in that original claim 40 of his '881 application reasonably conveyed to persons of skill in this field that he possessed the invention of the count.

Hyatt argues that "reasonably conveys to the artisan" is a less rigorous and more reasonable measure of the written description requirement than the "necessary and only reasonable construction" standard that the Board applied. Precedent has used both phrases, as well as others. See, *e.g.*, *In re Wertheim*, 646 F.2d 527, 538-39, 209 USPQ 554, 565 (CCPA 1981) (the disclosure relied on must "constitute[] a full, clear, concise and exact description . . . of the invention claimed"). We do not view these various expressions as setting divergent standards for compliance with § 112. In all cases, the purpose of the description requirement is "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). Thus, the written description must include all of the limitations of the interference count, or the applicant must show that any absent text is necessarily comprehended in the description provided and would have been so understood at the time the patent application was filed.

The Board did not clearly err in finding that Hyatt did not establish in the '881 application's written description that he possessed the entire subject matter of the count. This finding comports with the criterion not only of whether the description conveyed to the artisan the specific subject matter of the count, but also of whether the applicant established that this was the necessary construction of that description. The written description must include the limitations of the count with sufficient clarity and specificity that "persons of ordinary skill in the art

will recognize from the disclosure that appellants invented processes including those limitations," *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). The denial to Hyatt of benefit of the '881 application date as constructive reduction to practice of the interference count is affirmed.

II

BOONE'S '565 APPLICATION

Hyatt objected to the action of the administrative patent judge in according Boone the benefit of the July 19, 1971 filing date of application Serial No. 163,565 (the '565 application), the first of ten applications culminating in the '541 application in interference. Hyatt's objection is that at least two of these ten applications are invalid continuation applications, thus breaking the chain of priority. Hyatt states that Boone's second and eighth applications, both of which were filed under the "streamlined" procedures of 37 C.F.R. § 1.60 (Rule 60) with photocopies of the prior specification and oath, contained amended claims and thus could not have been filed under Rule 60, but required a new oath. Boone concedes the facts of these filings, but argues that these are not flaws, or not flaws fatal to his entitlement to trace priority through the chain.

Rule 60, at the time of Boone's first challenged continuation application in 1973, was as follows:

> **37 C.F.R. § 1.60 [1973].** A continuation or divisional application . . . which discloses and claims only subject matter disclosed in a prior application may be filed as a separate application before the patenting or abandonment of or termination of proceedings on the prior application. If the application papers comprise a copy of the prior application as filed, signing and execution by the applicant may be omitted . . . . Only amendments reducing the num-

> ber of claims or adding a reference to the prior application (§ 1.78(a)) will be entered before calculating the filing fee and granting of the filing date.

By 1987, when Boone's eighth continuation was filed, Rule 60 had been elaborated as follows:

> **37 C.F.R. § 1.60(b) [1987].** An applicant may omit signing of the oath or declaration in a continuation or divisional application if . . . (2) applicant files a true copy of the prior complete application as filed including the specification (including claims), drawings, oath or declaration showing the signature or an indication it was signed, and any amendments referred to in the oath or declaration filed to complete the prior application . . . . Only amendments reducing the number of claims or adding a reference to the prior application (§ 1.78(a)) will be entered before calculating the filing fee and granting of the filing date.

From the text of these provisions, it is not clear whether any technical violation of Rule 60 actually occurred with the presentation of amended claims. The administrative patent judge found none. No objection to compliance with Rule 60 was raised by the PTO at the time these applications were filed and prosecuted. The issue here raised is not one of substantive continuity of disclosure, but solely of whether a photocopy of the prior oath, instead of a new oath, was acceptable for filing, when it was in fact accepted for filing. Any technical deficiency in meeting the formal requirements of Rule 60 must be viewed in light of the agency's acceptance of the applications as in compliance with the Rule. Regularity of routine administrative procedures is presumed, and departure therefrom, should such have occurred, is not grounds of collateral attack. Courts should not readily intervene in the day-to-day operations of an administrative agency, especially when the agency practice is in straightforward implementation of the statute. *Cf. Vermont Yankee Nu-*

clear Power Corp. v. Natural Resources Defense Council, Inc., 435 U.S. 519 (1978) ("[T]his Court has for more than four decades emphasized that the formulation of procedures was basically to be left within the discretion of the agencies to which Congress had confided the responsibility for substantive judgments."); *Federal Power Comm'n v. Transcontinental Gas Pipe Line Corp.*, 423 U.S. 326, 333-34 (1976) (" 'The Court, it is true, has power 'to affirm, modify, or set aside' the order of the Commission 'in whole or in part.' . . . But that authority is not power to exercise an essentially administrative function.' ") (quoting *Federal Power Comm'n v. Idaho Power Co.*, 344 U.S. 17, 21 (1952)). We also take note, as held in *Weil v. Fritz*, 572 F.2d 856, 863, 196 USPQ 600, 606 (CCPA 1978), that the "applicant's oath is not a requirement of § 112, first paragraph, but of 35 U.S.C. § 115; therefore, the sufficiency of [the prior] oath is not material under § 120."

We discern no reversible error in the grant to Boone of the benefit of his chain of filings.

III

BOONE'S CROSS-APPEAL

The Board declined to enter judgment in favor of Boone, and entered judgment against Boone based on his request that his application be converted into a Statutory Invention Registration (SIR). Boone appeals the Board's refusal to rule on the patentability of his claims, which had been rejected on the ground of double patenting, and states that the Board erred in its refusal to enter judgment that the issue of priority was decided in his favor.

At the hearing before the Board Boone renewed his request that the '541 application be converted into a Statutory Invention Registration in accordance with 35 U.S.C. § 157. The SIR permits an inventor to forego the grant of a patent while preserving the opportunity to contest

priority through interference proceedings. The statute provides:

> **35 U.S.C. § 157. Statutory invention registration**
>
> (a) Notwithstanding any other provision of this title, the Commissioner is authorized to publish a statutory invention registration containing the specification and drawings of a regularly filed application for a patent without examination if the applicant—
>
> (1) meets the requirements of section 112 of this title;
>
> (2) has complied with the requirements for printing, as set forth in regulations of the Commissioner;
>
> (3) waives the right to receive a patent on the invention within such period as may be prescribed by the Commissioner; and
>
> (4) pays application, publication, and other processing fees established by the Commissioner.
>
> * * * *
>
> (c) A statutory invention registration published pursuant to this section shall have all of the attributes specified for patents in this title except those specified in section 183 and sections 271 through 289 of this title. A statutory invention registration shall not have any of the attributes specified for patents in any other provision of law other than this title. . . . The invention with respect to which a statutory invention certificate is published is not a patented invention for purposes of section 292 of this title.

The inventor of the SIR has "the same rights that a patent provides to prevent others from patenting the invention." *Section-by-Section Analysis: Patent Law Amendments of 1984*, 130 Cong. Rec. H10525 (Oct. 1, 1984), *reprinted in* 1984 U.S.C.C.A.N. 5827, 5828. The

inventor preserves the ability to protect the right to practice his own prior invention as against any later inventor, while foregoing the right to exclude others even if he is the prior inventor. Thus the SIR affords an inventor the possibility of securing the defensive aspects of a patent by obtaining the right to contest priority, while agreeing to publish the technology, thereby benefitting the public. *Id.*

Boone moved for permission to convert his '541 application to a SIR, after Boone had initiated this interference with Hyatt and Boone's '541 application was rejected, on Hyatt's motion, on the ground of double patenting. Boone argues that the conversion of the '541 application to the SIR removed the only obstacle to patentability raised by the double patenting rejection, *i.e.* that of extension of effective patent life, because the SIR—since it is not an enforceable patent—would not effectively extend the patentee's right to exclude. Boone argues that he is entitled to a decision as to patentabiilty although he will not obtain a patent.

The Board did not err in declining to rule on this issue in view of Boone's requested conversion to a SIR. Although Boone states that he is free to withdraw the SIR application at any time until the PTO has given notice of the intent to publish it, the intervening event of the interference proceeding has eliminated this option. Although administrative flexibiilty to accommodate changed circumstances or interests is a benefit of agency practice, there is rarely room for a complete change in position after the contrary position had achieved its purpose in a contested situation. We draw analogy to the rules of integrity in judicial proceedings. *See, e.g., Davis v. Wakelee*, 156 U.S. 680, 689 (1895) ("[W]here a party assumes a certain position in a legal proceeding, and succeeds in maintaining that position, he may not thereafter, simply because his interests have changed, assume a contrary position, especially if it be to the prejudice of the party

who has acquiesced in the position formerly taken by him."); *cf. U.S. Philips Corp. v. Sears, Roebuck & Co.*, 55 F.3d 592, 596-97, 34 USPQ2d 1699, 1702-03 (Fed. Cir. 1995) (equity holds a party to a position on which it prevailed).

The Board has instructed that Boone's application be examined for the purpose of publication as a SIR. Indeed, Boone has repeated on this appeal that he has no objection to this procedure. In view of Boone's action in requesting conversion to a SIR and the ensuing proceedings, the Board did not err in holidng that Boone is not entitled to a patent on the '541 application. However, the patent interference statute requires the Board to determine which party has prevailed on the issue of priority. 35 U.S.C. § 135(a) ("The Board of Patent Appeals and Interferences shall determine questions of priority . . . .").

Priority issues that have been fully developed and presented for decision should be decided. *See Guinn v. Kopf*, 96 F.3d 1419, 1422, 40 USPQ2d 1157, 1159 (Fed. Cir. 1996). Indeed, the Board did decide priority, for the Board held that Hyatt was not entitled to the benefit of his '881 application date, and confirmed that Boone was entitled to his '565 application date. The Board's reason for refusing to recognize Boone's status as prior inventor was that Boone "was not entitled to a patent by express waiver of that right," citing 35 U.S.C. § 157(a)(3). However, the SIR waiver does not affect the adjudication of priority in resolution of the interference proceeding. The Board's statement, in its reconsideration decision, that it could not adjudge Boone to be prior inventor without also holding that Boone was entitled to a patent, citing 37 C.F.R. § 1.658(a), is an unwarranted reading of the regulation and is unsupported by the statute. Although the Board correctly ruled that Boone was not entitled to a patent, that ruling is not inconsistent with an adjudication of priority. Thus the judgment is modified to state that priority as to the count is awarded to Boone.

SUMMARY

The Board's decision that Hyatt is not entitled to the priority date of the '881 application as to the subject matter of the count is affirmed, as is the Board's decision that Boone is not entitled to a patent on this subject matter. However, judgment of priority in the interference contest shall be entered in favor of Boone.

No costs.

AFFIRMED, MODIFIED IN PART

APPENDIX B

[Filed Jun. 30, 1998]

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1514, 96-1515

HYATT

v.

BOONE

ORDER

UPON CONSIDERATION of Appellant's Motion to Extend Time for Filing Petition for Rehearing and Suggestion for Rehearing En Banc,

IT IS ORDERED that:

The Motion is granted, and the time for filing a Petition for Rehearing and Suggestion for Rehearing En Banc shall be extended fourteen (14) days or to and including July 15, 1998.

FOR THE COURT:

/s/ Jan Horbaly
JAN HORBALY
Clerk

Date: 6/30/98

APPENDIX C

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1514, -1515
(Interference No. 102,598)

GILBERT P. HYATT,
Appellant,

v.

GARY W. BOONE,
Cross-Appellant.

On Appeal from the United States Patent and Trademark Office Board of Patent Appeals and Interferences

In Case No(s). Interference No. 102,598

JUDGMENT

This CAUSE having been heard and considered, it is ORDERED and ADJUDGED: AFFIRMED, MODIFIED IN PART

ENTERED BY ORDER
OF THE COURT

/s/ Jan Horbaly
JAN HORBALY
Clerk

Dated Jun. 17, 1998

APPENDIX D

[Filed Aug. 26, 1998]

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1514, -1515
(Interference No. 102,598)

GILBERT P. HYATT,
Appellant,

v.

GARY W. BOONE,
Cross-Appellant.

ORDER

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and a response thereto having been invited by the court and filed by the CROSS-APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc and response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on September 2, 1998.

FOR THE COURT

/s/ Jan Horbaly
JAN HORBALY
Clerk

Dated: August 26, 1998

APPENDIX E

Paper No. 263

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

GILBERT P. HYATT,
Junior Party,[1]

v.

GARY W. BOONE,
Senior Party.[2]

Patent Interference No. 102,598

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[1] Patent 4,942,516, granted July 17, 1990, based on Application 07/209,115, filed June 17, 1988. Accorded the benefit of U.S. Application Nos. 06/223, 959, filed January 12, 1981; 05/860,253, filed December 14, 1977; 05/860,256, filed December 14, 1977, now Patent No. 4,829,419, granted May 9, 1989; and 05/860,258, filed December 14, 1977.

[2] Application 07/473,541, filed February 1, 1990. Accorded the benefit of U.S. Application Nos. 07/325,703, filed March 20, 1989; 07/097,489, filed September 15, 1987; 06/915,857, filed October 6, 1986; 06/750,647, filed June 28, 1985; 06/604,404, filed April 27, 1984; 06/002,815, filed January 12, 1979; 05/856,932, filed December 2, 1977, now Patent No. 4,242,675, granted December 30, 1980; 05/420,999, filed December 3, 1973, and 05/163,565, filed July 19, 1971.

FINAL HEARING: March 21, 1995

Before URYNOWICZ, PATE, and LEE, *Administrative Patent Judges.*

PER CURIAM.

Except for the section on *res judicata*/collateral estoppel, Judges Pate and Lee join the entire opinion of Judge Urynowicz. On the issue of *res judicata*/collateral estoppel, Judges Pate and Lee write separately and each concludes that Hyatt should not be estopped from arguing that the disclosure of its U.S. parent application S.N. 101,881 filed December 28, 1970 is enabling with respect to the subject matter of the count.

FINAL DECISION

The invention in issue relates to a computer on a chip. The particular subject matter in issue is defined by the following single count, which is identical to claim 29 of Hyatt, the junior party patentee, and claim 92 of Boone, the senior party applicant.

Count 1

A computer on a chip comprising:

an integrated circuit chip having a computer implemented thereon;

an integrated circuit main memory storing computer instructions, wherein said integrated circuit main memory is included on said integrated circuit chip;

an integrated circuit operand memory storing operands, wherein said integrated circuit operand memory is included on said integrated circuit chip; and

an integrated circuit processing circuit processing the operands stored by said integrated circuit operand memory in response to the instructions stored by said integrated circuit main memory, wherein said processing circuit is included on said integrated circuit chip.

The claims of the parties which correspond to this count are:

Hyatt: Claims 1-3, 6-9, 15, 16, 25-31 and 33-35

Boone: Claims 83-98

This interference was provoked by the party Boone when it copied claims of the involved Hyatt patent into its involved application on January 15, 1991 (Paper No. 16 of the Boone application). The proceeding was declared on March 27, 1991 with counts 1 and 2. At that time, the party Hyatt was accorded benefit with respect to the counts of four prior applications, giving it an effective filing date of December 14, 1977; the party Boone was accorded benefit of a series of nine prior applications, giving it an earlier effective filing date of July 19, 1971. Based on its earlier effective filing date, Boone was accorded senior party status.

Numerous preliminary motions under 37 CFR § 1.633 were filed by the parties in the time set for filing such motions. A *Decision on Preliminary Motions* was rendered April 27, 1992. Of particular interest at final hearing are the following rulings of the Examiner-in-Chief [3] in his decision. Boone's motion under 37 CFR § 1.633(c) to redefine the interfering subject matter by designating Hyatt claims 4, 5, 10-14, 17, 19-24 and 32 as corresponding to count 1 and Hyatt claim 18 as corresponding to count 2 (Paper No. 25) and the senior party's alternative motion in that paper to add claims 99-114 to its involved application and to add sixteen new counts

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[3] The title has since been changed to Administrative Patent Judge (APJ), which will be used hereinafter.

corresponding to each of claims 99-114 and Hyatt claims 4, 5, 10-14, 17-24 and 32, were denied. Boone's motion under 37 CFR § 1.633(c)(1) to redefine the interfering subject matter by substituting count A for count 2 (Paper No. 37) was denied and in a *sua sponte* action of the APJ, count 3, to which Hyatt's claim 35 and Boone's claim 97 correspond exactly, was substituted for count 2. The motion of Hyatt under 37 CFR § 1.663(a) for judgment that all of the Boone claims corresponding to both counts are unpatentable as a result of either: (1) deceptive intention in initially naming Michael J. Cochran as a co-inventor in the Boone application in interference, or (2) deleting Mr. Cochran as a co-inventor at the time of requesting the present interference, and the accompanying request for testimony and to defer the motion to final hearing (Paper No. 14) were denied. The motion of Hyatt under 37 CFR § 1.633(a) for judgment on the grounds that all of Boone's claims corresponding to the counts are unpatentable to Boone under 35 U.S.C. § 112, first paragraph, on the ground that its specification does not provide written description for the full scope of the invention as claimed (Paper No. 15) was denied. The motion of Hyatt under 37 CFR § 1.633(a) for judgment that Boone's claims corresponding to count 1 are unpatentable by reason of double patenting (Paper 16) was granted. The motions of Hyatt under 37 CFR § 1.633(g) to deny party Boone the benefit of the filing dates of its earlier filed applications (Paper No. 17) and under 37 CFR § 1.633(f) to be accorded benefit of the December 28, 1970 and October 1, 1973 filing dates of application Serial Nos. 05/101,881 and 05/402,520, respectively, (Paper No. 12) were denied. The motion of Boone under 37 CFR § 1.633(a) for judgment on the grounds that all of Hyatt's claims corresponding to the counts are unpatentable to Hyatt under 35 U.S.C. §§ 102/103 (Paper No. 23) was granted.

In view of the finding of unpatentability of all claims of the parties Hyatt and Boone which correspond to count

1 and of all claims of Hyatt corresponding to new count 3 in the *Decision on Preliminary Motions*, notice was given pursuant to the provisions of 37 CFR § 1.640(d) that judgment on the record as to those claims would be entered against the parties unless they show cause why such judgment should not be rendered. In response, the parties Hyatt and Boone filed requests for final hearing (Paper Nos. 115 and 116, respectively) to review the matters which were decided in the *Decision on Preliminary Motions*; these requests were granted (Paper No. 133).

Subsequent to the *Decision on Preliminary Motions*, the APJ issued a paper amending that decision (Paper No. 125). In that paper, the APJ moved *sua sponte* to redefine the interfering subject matter by deleting count 3 and by designating those claims of the parties corresponding to count 3 as corresponding to count 1. The interference was redeclared with only count 1 (Paper No. 134).

Both parties submitted evidence in support of their positions at final hearings, filed briefs and appeared for oral argument.[4]

Correspondence of Additional Hyatt Claims

Boone contends that its motion to redefine the interfering subject matter by designating Hyatt claims 4, 5, 10-14, 17-24 and 32 as corresponding claims (Paper No. 25) should not have been denied by the APJ. In the alternative, Boone seeks to add new counts to this interference corresponding to the above claims of Hyatt, which claims Boone has copied into its involved application.

In its brief, Boone takes the position that it has established as required under 37 CFR § 1.637(c)(3)(ii) that

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[4] In the *STATEMENT OF ISSUES* at page 2, items 1-3, of its main brief, *res judicata*/collateral estoppel, enablement under 35 U.S.C. § 112 and written description under 35 U.S.C. § 112 are raised by Hyatt only with respect to its '881 application.

each of the above claims defines the same patentable invention as count 1. In response, Hyatt contends that none of the above claims should be added to this interference. At pages 74-78 of its reply brief, the junior party specifically argues the subject matter of its claims 4 and 5. For the remaining proposed claims, Hyatt simply makes the broad contention that the references cited by Boone to establish that each claim defines the same patentable invention as the count under 37 CFR § 1.637(c)(3)(ii) do not show the claimed features.

Boone argues that dependent claim 4 adds no patentable distinctions to corresponding claim 1 of Hyatt, from which it depends. Purportedly, it merely adds the requirements that the read only memory is arranged to store the computer instructions as eight-bit bytes and that the processing circuit includes a transfer instruction execution circuit including a first accessing circuit accessing three sequential eight-bit bytes stored by said integrated circuit read only memory and a transfer control circuit coupled to the first accessing circuit and transferring control to a next instruction in response to the three eight-bit bytes accessed by said first accessing circuit. The senior party asserts that the requirement that the computer store instructions as eight-bit bytes has already been determined in this interference to be an obvious variation of count 1. In particular, Hyatt claims 2 and 3, which specify that the computer operate with instructions stored as eight-bit bytes, have already been designated as corresponding to count 1.

Boone contends that both storing instructions as eight-bit bytes and the circuitry for executing three byte transfer instructions were well-known features of multi-chip computers by 1970. Boone asserts the book by Yaohan Chu, *Digital Computer Design Fundamentals* (McGraw-Hill Book Company, Inc., 1962), of record (Paper Nos. 152 and 164), discloses a computer with both of these features in Chapter 12, at pages 459-461, in connection

with a configuration for a serial digital computer. The particular example is for a 32-bit word that is transferred in a sequence of four word times or bytes. The word is accessed and read into an instruction circulating register, and an address part of the word is read into an operation-code register. Also, transfer instructions are used to change the program control sequence wherein the contents of the instruction circulating register are transferred to the next instruction circulating register. As can be seen from this example, it was well-known in the art to sequentially access stored eight-bit bytes and execute transfer instructions. The example in Chu is for a sequence of four bytes rather than the claimed three but this is simply a design choice based on the size of the word instruction to be transferred. These aspects of computer design were thus well-known in 1970.

According to Boone, claim 5 of Hyatt is obvious over count 1 for reasons very similar to those concerning claim 4 as discussed above. As to the eight-bit byte limitation, that is merely an obvious embellishment to the count for the same reasons as discussed above in connection with Hyatt claim 4. As to the transfer execution circuit of claim 5, this exact scheme is taught in U.S. Patent 3,400,371 to Amdahl et al., of record (Paper No. 152), for use in a data processing system.

With respect to claim 4, Hyatt contends that: (1) the four byte fixed length instruction format taught by Chu does not suggest the three byte format of the claim; (2) all four bytes of an instruction of the reference are read during the second 32-digit word time and not in four word times as contended by Boone and not in three sequential byte times as set forth in claim 4; and (3) the record is devoid of any evidence as to why it would have been obvious to apply Chu's drum based computer operation to the single chip computer of the count to arrive at the computer defined in claim 4.

Hyatt argues that claim 5 is not rendered obvious by the combination of U.S. Patent 3,400,371 to Amdahl and the count since the Branch on Index High instruction of the patent shown in Fig. 23 has 32 bits, not three bytes as required by claim 5.

We are of the opinion that Hyatt claims 4, 5, 10-14, 17-24 and 32 correspond to count 1.

With respect to claim 4, at pages 459-461, Chu discloses a computer configuration wherein transfer instructions are utilized not only to maintain a program control sequence but also to change the sequence.[5] With respect to Hyatt's arguments, claim 4 is not limited to a three byte format. The recitation of three bytes is met by Chu's four byte format. However, even if claim 4 were limited to a three byte format, this would be obvious over the count and Chu since Chu discloses the use of formats having 2 to 5 bytes at Figs. 12-24 of page 452.

We agree with Hyatt that the Chu text at pages 459-461 discloses that all four bytes of an instruction are read out of memory during the second 32-digit word time and not in four word times as contended by Boone, and certainly not in three sequential byte times. However, claim 4 does not require sequential accessing of three bytes but rather merely recites three sequential bytes. The bytes of an instruction in Chu are sequential as stored in memory as shown at Figs. 12-24 of the Chu text.

The fact that Chu's serial digital computer operation at pages 459-461 is explained utilizing a magnetic-drum memory does not affect the significance of this disclosure. It is clear from these pages of the text that the computer configuration utilizing a magnetic-drum memory is but

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[5] We note that at column 12, lines 15-23, of Hyatt's involved patent, it states that the data processor 12 is organized to operate in a manner similar to known stored program digital computers and that such systems are described in Chu.

one example of a configuration for a serial digital computer. At page 459, Chu states:

> A serial digital computer offers the advantage of using fewer components and circuits, particularly if a sequential memory such as the magnetic-drum memory is used.

Hyatt's sole argument with respect to claim 5 is not persuasive. Corresponding Hyatt claim 2, concerning which Hyatt filed no motion to redefine the interfering subject matter under 37 CFR § 1.633(c) by designating the claim as not corresponding to count 1, defines computer instructions and that at least one of the instructions is an eight-bit byte. Accordingly, this corresponding claim, which by definition defines the same patentable invention as the count (37 CFR § 1.601(f)), teaches plural instructions, each comprising an eight-bit byte. Thus, Hyatt claim 5, which calls for an instruction of three eight-bit bytes, does not define a separate patentable invention from claim 2 or the count.[6]

Furthermore, Hyatt dependent claim 5 is not limited to three bytes. Fig. 23 of the Amdahl patent discloses a 32-bit instruction having four bytes with eight bits/byte which encompasses the three bytes of claim 5. That Fig. 23 consists of four bytes is apparent from a comparison of Figs. 20 and 23, and the description of Fig. 20 at column 23 of the patent indicating that the figure is a scale of the relationship of the byte, half word, word and double word for use with Figs. 20a and 21-26. Thus, the Amdahl patent renders obvious the additional subject matter of dependent claim 5.[7]

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[6] Similarly, Hyatt's argument is not persuasive when considered in light of Hyatt's corresponding claim 3 which recites computer instructions as eight-bit bytes.

[7] It is apparent to us that Amdahl also renders obvious the broader subject matter defined in Hyatt dependent claim 4.

Whereas Hyatt has not specifically opposed Boone's analysis for same patentable invention of claims 10-14, 17-24 and 32 with respect to count 1 made at pages 70-86 of its brief and since we are persuaded by that analysis, we hold that the above claims define the same patentable invention as the count. 37 CFR § 1.637(c)(3)(ii).

Hyatt's Written Description

Hyatt contends that the APJ's finding in the *Decision on Preliminary Motions* that its '881 application fails to meet the written description requirement of 35 U.S.C. § 112, first paragraph, cannot be sustained. According to the junior party, the description of a single chip "data processing system" in original claim 40 of the '881 application including "read only memory means," and "alterable memory means" describes a computer on a chip as defined by the count. Hyatt asserts that the only issue is whether original claim 40 in the context of the '881 application "reasonably conveys to the artisan" a single chip computer including a "processing circuit" as defined by the count.

According to Hyatt, the term "data processing system" used in claim 40 is a system which processes data and which necessarily includes a data processing circuit. Without a processing circuit, no processing could occur in the system on the chip. Allegedly, those skilled in the computer design art agree that claim 40 directs a skilled artisan to place a processor on a single chip. As noted by the junior party at page 41 of its brief, Salzer and Lee, two of Hyatt's witnesses that are computer designers, stated:

> A computer designer of ordinary skill in the art on December 28, 1970, would have recognized the terms "computer," "data processor" and "electronic data processing system" as referring to a computing device that would necessarily have a processing cir-

> cuit. [Salzer, HR 18/1730; Lee similarly at HR 18/1749].

These witnesses further indicated that, as viewed by a skilled computer designer, the term "program means" refers to a circuit that responds to a program, not to a program itself and, thus, refers to the processing circuit.

In opposition, the party Boone states that aforementioned claim 40 does not include on a single chip all the elements required by the count. In particular, claim 40 omits the count's "integrated circuit processing circuit processing the operands stored by said integrated circuit operand memory in response to the instructions stored by said integrated circuit main memory."

Boone asserts that in an effort to cure this deficiency, Hyatt contends that the "processing circuit" processing operands from alterable memory in response to program instructions from main memory can be found in the "program means" of claim 40. However, the common usage of "program means" in the Hyatt specification illustrates the "program" and "program means" are intended to describe only a set of computer instructions or as a modifier to phrases such as "program control means," not a processing circuit operating under control of those instructions. Hyatt used the term "program means" in only one other place in the 1970 application, that being in original claim 70. The claim includes the following paragraph:

> an electronic data processor including memory means, computation means and program means operatively dispersed to monitor said rudimentary, intrinsic input signals at a relatively high data rate, convert said input signals to base data processor signals, interpret said converted signals and generate appropriate system responses.

According to Boone, this claim, which speaks separately of "computation means" and "program means," makes it clear that as used in the 1970 specification the phrase

"program means" does not mean a computation or processing means.

We agree with the APJ and Boone that Hyatt's '881 application fails to meet the written description requirement of 35 U.S.C. § 112, first paragraph, and that Hyatt is not entitled to benefit of either of these prior applications for that reason.

Original claim 40 of the '881 application reads as follows:

> 40. An electronic data processing system including read only memory means, alterable memory means and program means, said system being implemented on a single integrated circuit chip.

The "processing system" of the preamble of claim 40 merely defines what the two memory means and the program means of the body of the claim collectively are intended to define. The preamble does not add a fourth element, i.e., processing circuit, to the three means recited in the claim. Accordingly, if the "integrated circuit processing circuit" of the count is supported in the prior applications, it must be by the recitation of "program means" in claim 40. That it must be by the recitation of "program means" seems to be Hyatt's position herein.

Claim 40 broadly defines two memory means and a "program means" whereas the count specifically defines a main memory storing computer instructions, an operand memory storing operands and a processing circuit processing the operands in response to the instructions. The claim recitations are broad and the read only memory means of claim 40 need not be a main memory storing computer instructions and the alterable memory means need not be an operand memory storing operands. The "program means" of the claim is not a processing circuit nor does the "program means" process operands in response to the stored instructions. As noted by Boone, the use of "program" and "program means" in the Hyatt

specification describes a set of computer instructions and Hyatt's original claim 70 makes it clear that the "program means" is not a processing circuit, as the "computation means" of the claim is the processing circuit. As noted by the APJ in his decision, the disclosure should be clearer than to suggest that one skilled in the art might construct the device in a particular manner. *Bocciarelli v. Huffman*, 232 F.2d 647, 109 USPQ 385 (CCPA 1956); *Brand v. Thomas*, 96 F.2d 301, 37 USPQ 505 (CCPA 1938). The disclosure must be sufficient when considered in its entirety such that the necessary and only reasonable construction to be given the disclosure by one skilled in the art is one which will lend clear support to each positive limitation in the count. *Dyer v. Field*, 386 F.2d 466, 156 USPQ 85 (CCPA 1967).

Testimony of the witnesses Salzer and Lee is not persuasive. They focus on the proposition that a data processing system must generally include a "processing circuit" of some sort without addressing whether a data processing system must necessarily include the specific processing circuit required by the count. The count does not simply recite a processing circuit with no specifically defined functions. Rather, a processing circuit with particularly defined functions is required by the count. While two memories and a computer program may generally constitute a data procesing system of some sort, they do not describe the invention set forth by the count.

Testimony of these witnesses indicating that "program means" refers to a circuit that responds to a program is unpersuasive. It is irrefutable that a program is "program means." Furthermore, if "program means" can be a circuit (processor) that responds to a program as indicated by the above witnesses, it is at least as likely that it can be a memory that merely stores a program without processing operands. The witnesses do not discuss the alternative possibilities. The "program means" as an alleged processing circuit does not have to operate on operands stored in an on-chip memory; the operands may be pro-

vided from elsewhere or, alternatively, there need not be any operands at all. It is not proper to accept affidavits in order to establish facts which the disclosure itself should provide in order to conform to the mandatory provisions of a statute (35 U.S.C. § 112). *In re Smyth*, 189 F.2d 982, 990, 90 USPQ 106, 112 (CCPA 1951).

Patentability of Hyatt's Involved Claims

In the *Decision on Preliminary Motions* (Paper No. 105), the involved claims of Hyatt were found unpatentable under 35 U.S.C. §§ 102/103 on any of the following art or grounds:

1. United Kingdom Patent No. 1,401,265, specification published July 23, 1975, patent sealed November 19, 1975;

2. U.S. Patent No. 3,934,233 issued January 20, 1976, filed September 24, 1973;

3. Texas Instruments Inc. *Programmer Reference Manual for TMS1000 Series MOS/LSI One-Chip Microcomputers* (1975); and

4. the invention was embodied in the following products that were in public use or on sale in the United States prior to December 14, 1976;

a. the TMS0100 series of microcomputer chips;

b. the Texas Instruments SR-10 calculator; and

c. the TMS1000 series of microcomputer chips.

Since the junior party does not argue the impropriety of the APJ's holding of unpatentability of its corresponding claims under 35 U.S.C. §§ 102/103 as aforementioned, since we held above that Hyatt is not entitled to benefit of the '881 application, and since we are aware of no reason why the holding of unpatentability of Hyatt's involved claims should be withdrawn, we sustain that holding. With respect to the claims of Hyatt newly added

as corresponding to the count, Hyatt has chosen not to argue their separate patentability over the prior art, even though the issue of their correspondence to the count was raised during the preliminary motions period. Accordingly, they fall with Hyatt's claims 1-3, 6-9, 15, 16, 25-31 and 33-35. *Cf. In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

We also sustain the holding of the APJ in his *Decision on Preliminary Motions* that all of Hyatt's corresponding claims are unpatentable to the junior party on the basis of its admission at page 2 of its opposition paper filed July 22, 1991 (Paper No. 47) that some of the art cited in the record of his involved patent would preclude patentability based on a 1977 effective filing date.

Hyatt's Conception

Boone contends at pages 32-35 of its brief that Hyatt's claims are unpatentable because of lack of conception. According to the senior party's brief at page 33, the general goal of placing all parts of a computer on a single chip was well-known before Hyatt entered the field. At pages 17 and 18 of its brief, Boone refers to four papers published prior to the November, 1967 date of conception alleged by Hyatt in its preliminary statement in support of this contention. Boone takes the position that since the inventor Hyatt testified on page 4 in his July 17, 1991 declaration that:

> I am not now and I have never been a chip designer or an integrated circuit processing person . . . . My plan had always been to take my single chip computer design to a company that built custom integrated circuits and let that company build my computer using one of their standard processes selected by them[,] . . . .

he did not know how to put all of the components of a computer on a single chip and never had a complete conception of a single chip computer.

In opposition, Hyatt contends to the effect that the senior party is not now entitled to raise the issue of the junior party's conception since priority of invention is not at issue at this time in the proceeding. The junior party also contends at page 48 of its brief that Boone's conception argument fails on the merits since:

> [w]hen *all* of the testimony is considered, it becomes clear that Hyatt (i) had a general knowledge of integrated circuit design and processing sufficient to conceive a single chip data processor, (ii) had a complete single chip data processor design that had been built in multi-chip form and disclosed that design in *inter alia* the '881 application, and (iii) relied on integrated circuit companies to manufacture his design using their standard integrated circuit processes and techniques. Hyatt merely relied on those skilled in the art of chip design and processing to use what was well known in the art to place his working design on a single chip (footnote omitted).

We agree with Hyatt that it is premature for Boone to raise the issue of conception by Hyatt at this stage of the proceeding. Testimony with respect to priority of invention has not been taken in this case as this case was set down for final hearing to review only matters addressed in the *Decision on Preliminary Motions.* See Paper No. 133.

Although we have ruled that it is not timely to consider conception by the junior party Hyatt at this time, as an aside, we make the following observation with respect to the patentability of its corresponding claims based on argument made by Boone charging that Hyatt did not conceive the invention. Recognizing that Hyatt admits to the effect that he did not have in mind a process or technique for building a single chip computer and assuming for purposes of argumentation Hyatt's position in this proceeding that in 1970, one of ordinary skill in the art of chip design would have been able to make the invention

described in the '881 application defined by the count, we are of the opinion that Hyatt's claims corresponding to the count are unpatentable over the prior art cited by Boone at pages 17 and 18 of its brief, and further noted by the senior party at page 33 of the brief. This art refers to putting a computer on a single chip [8] and it became applicable against Hyatt when it became enabled by late 1970 by one other than Hyatt skilled in the art to which the invention pertains. Before a publication can be used to reject an application, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. *Cf. In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). Thus, even assuming we had reached a decision on the merits on the issue of enablement and held that Hyatt proved its position that in 1970 those skilled in the art of chip design were able to build a computer on a single chip and Hyatt's '881 application was otherwise in compliance with 35 U.S.C. § 112, first paragraph, judgment would have been awarded against Hyatt on the basis that its corresponding claims are not patentable to it over the prior art. If the actual prior art reference anticipates the subject matter of the count, as here, all claims that have been designated as corresponding to that count would be unpatentable for anticipation or obviousness. *In re Van Geuns, supra.*

In accord with the above assumption regarding enablement, since the idea of placing the parts of a basic computer on a single chip was known prior to Hyatt's earliest alleged fact with respect to the invention in its preliminary statement (November, 1967) and since the junior party relies on one skilled in the art in 1970 to enable its own

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[8] According to Hyatt's main brief at pages 8-12, a computer includes a main memory storing instructions (item a., pages 9 and 10), a second memory storing operands (item b., pages 10 and 11) and a processing circuit processing operands stored in the second memory in response to instructions stored in the main memory.

subsequent idea of placing a computer on a chip, it would not have been possible for Hyatt to successfully make oath or declaration under 37 CFR § 1.131 showing completion of the invention before the date of enablement of the aforementioned prior art cited by Boone.

Boone's Request for a Statutory Invention Registration

In its brief at final hearing, the senior party states that, in pursuing this interference, it is not the goal of Boone and Texas Instruments to obtain an enforceable patent covering the fundamental invention of a single-chip computer. Accordingly, Boone renews a prior request that the Board consent to the entry of a letter requesting a Statutory Invention Registration (SIR) under 35 U.S.C. § 157 for its involved application.

We are aware of no reason why Boone's request should not be considered favorably and, accordingly, grant the request to the extent that Boone's application will be remanded to the primary examiner for examination as a SIR application upon termination of this proceeding.

The parties to an interference are presumed to have made their inventions in the chronological order of their effective filing dates. 37 CFR § 1.657(a). Since Boone has the earlier effective filing date in this case, that presumption applies to party Boone, who is accordingly considered to be the prior inventor of the subject matter in issue. However, favorable judgment is normally rendered in an interference only with respect to parties which are patentees, or with respect to applicants whose goal it is to obtain a patent. Since Boone's request for a SIR application makes it evident that it is not such an applicant and that it is not entitled to a patent by express waiver of that right in its involved application (35 U.S.C. § 157 (a)(3)), judgment will not be entered in Boone's favor.

Since our findings above are dispositive of this interference with respect to Hyatt, except for the issue of *res*

judicata/collateral estoppel discussed below, we do not reach other issues raised by the parties for decision at final hearing with respect to the junior party. In view of the foregoing decision concerning the Boone application, we need not reach the issues raised by Hyatt with respect to the senior party.

Hyatt's Motion for Benefit of Serial No. 05/101,881—Res Judicata/Collateral Estoppel

URYNOWICZ, Administrative Patent Judge.

The junior party contends that it is not bound by the adverse *ex parte* decision of June 9, 1988 of the U.S. Court of Appeals for the Federal Circuit (*In re Hyatt*, No. 87-1597 (Fed. Cir. June 9, 1988) (non-precedential)) in its prior application S.N. 05/860,253 filed December 14, 1977 (the '253 application) from obtaining benefit as to the count of prior application Serial No. 05/101,881 filed December 28, 1970 (the '881 application).[9] In that decision, the Federal Circuit affirmed the decision of the Board sustaining the rejection of all claims of the '253 application as not patentable under 35 U.S.C. § 112, first paragraph, since, with respect to the date of the '881 application:

> [a]ppellant has not come close to presenting sufficient evidence to make a persuasive case that a routineer in the integrated circuit art in 1970, presented with appellant's disclosure and supplementing it with what was well known in the art, could have implemented appellant's computer on a single chip without undue experimentation.

Page 9 of the court's opinion.

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[9] The '253 application is a continuation-in-part of the '881 application. Inspection of the files reveals that appealed claims 1 and 45 of the '253 application and count 1 of this interference broadly define a computer on a chip and are of the same scope. The claims and count 1 are essentially the same.

According to Hyatt, *ex parte* prosecution cannot be properly characterized as either a dispute or litigation. *In re Craig*, 411 F.2d 1333, 1335-36, 162 USPQ 157, 159 (CCPA 1969) and, the use of *res judicata* in continuing patent applications after an *ex parte* appeal has been materially restricted. *In re Herr*, 377 F.2d 610, 611, 153 USPQ 548, 549 (CCPA 1967). Hyatt contends that the aforementioned decisions are controlling and that as an applicant in S.N. 209,115 (the '115 application) submitting new evidence and/or claims, it was not bound by a prior adverse decision in its parent '253 application by the Board of Patent Appeals and Interferences or the Federal Circuit.[10] *Herr, supra*, 377 F.2d at 611, 153 USPQ at 549, *Craig, supra*. Also, *In re Russell*, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971), and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

The senior party Boone avers that Hyatt is bound under principles of *res judicata*/collateral estoppel by the Federal Circuit's prior determination to the effect that Hyatt's '253 and '881 applications are not enabling with respect to a computer on a chip. Furthermore, at page 11 of its brief, Boone draws attention to the fact that, in prosecuting the application that matured into the '516 patent, Hyatt argued that the Federal Circuit decision "can now be considered to be 'law of the case' herein and this can be considered to be res judicata herein."

Boone states that Hyatt misreads *Herr, supra*, and that a correct reading of the case indicates that the junior party patentee should be bound by the aforementioned 1988 Federal Circuit decision. Boone brief, page 11. According to the senior party, *Herr, supra*, presented the issue of whether an applicant whose claims in a parent application had previously been rejected over prior art and then had that rejection affirmed by an appellate court, was bound in his continuing application to the results of

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[10] The '115 application matured into involved Hyatt U.S. Patent 4,942,516 (the '516 patent).

that affirmance by prinicples of *res judicata*/collateral estoppel. While the court concluded in a 3-2 split decision that these principles did not apply to the facts in that case involving a rejection of claims in a parent application over prior art, it did not erect any sweeping rule that decisions on appeal from *ex parte* rejections of claims have no *res judicata*/collateral estoppel effect.

Boone cites the language of Judge Rich in his concurring opinion at 377 F.2d at 619, 153 USPQ at 555 of the *Herr, supra*, decision that:

> Where an appellate court has decided a *specific* question, for example that the disclosure of an application is inoperative as in Hemphill v. Coe and *In re Lawson*, or that claims are not supported by the disclosure of an application within the meaning of 35 U.S.C. § 112, . . . the doctrine of collateral estoppel should normally prevent relitigation of that issue.[11]

The senior party notes that the court in *California Computer Products, Inc. v. Simplicity Pattern Co.*, 194 USPQ 367, 370 (C.D. Cal. 1977), applied Judge Rich's above analysis to a case involving a continuation where the parent had previously been held by the Court of Customs and Patent Appeals to have an inadequate disclosure under 35 U.S.C. § 112.

It is considered that Hyatt is bound by the decision of the Federal Circuit in *Hyatt, supra*, dated June 9, 1988 in its parent '253 application and, thus, that Hyatt is not entitled to benefit of the '881 application in this proceeding on the basis of *res judicata*/collateral estoppel. To serve as a constructive reduction to practice, the disclosure of the subject matter of the count must meet the requirements of 35 U.S.C. § 112, first paragraph. *Bigham v. Godtfredsen*, 857 F.2d 1415, 8 USPQ2d 1266 (Fed. Cir. 1988).

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[11] *Hemphill Co. v. Coe*, 121 F.2d 897, 49 USPQ 484 (D.C. Cir. 1941); *In re Lawson*, 70 F.2d 373, 21 USPQ 390 (CCPA 1934).

Hyatt misconstrues *Herr, supra.* In his concurring opinion in that case, Judge Rich indicated that in the administrative process of patent granting, including appellate review of rejections, estoppel by prior judgment should be applied only in the clearest cases of attempted reargument of previously decided issues. He further indicated to the effect that *res judicata* was devised in connection with the litigation of disputes, not with respect to the application for government grant of statutory rights dependent for issuance on compliance with stated conditions. The concuring opinion made an important distinction, stating to the effect that there is an essential difference between *ex parte* and *inter partes* cases with respect to *res judicata* in the U.S. Patent and Trademark Office (PTO). However, with respect to *ex parte* appeals Judge Rich asserted that where an appellate court has decided a specific question such as that the disclosure of an application for patent is inoperative as in *Hemphill, supra* and *Lawson, supra,* the doctrine of collateral estoppel should normally prevent relitigation of that issue.

Hemphill, supra, was first adjudicated in the Court of Customs and Patent Appeals (CCPA) as *Lawson, supra,* one holding of the court being that the disclosure in the parent application was inoperative. A second application was filed but was subject to an intervening bar by public use unless the filing date of the parent was available. In considering the new rejection of the second application on the public use bar, the Court of Appeals for the District of Columbia refused to reconsider the specific question of inoperativeness which had been decided by the CCPA, a question which related to the identical application on which the CCPA had ruled. In effect, its decision was to accept as final the decision of the CCPA on the inadequacy of the parent application as a disclosure.

While a party such as Hyatt against whom a plea of preclusion is asserted must have been a party to the prior proceeding, a party such as Boone asserting the plea need

not have been. *Blonder-Tongue Lab., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313, 169 USPQ 513 (1971). Here, we have an *inter partes* case involving a dispute. Like *Hemphill, supra*, and *In re Szwarc*, 319 F.2d 277, 138 USPQ 208 (CCPA 1963), a specific question involving the adequacy of disclosure of an application for patent has been decided by a court of appeals in the negative. Thus, like the Court of Appeals for the District of Columbia in *Hemphill* and the Court of Customs and Patent appeals in *Szwarc*, the Board should refuse to reconsider the question of adequacy of disclosure which has been decided by an appeals court. Hyatt had a fair opportunity procedurally, substantively and evidentially to pursue his claim of enablement during the pendency of the '253 application. *Blonder-Tongue, supra.* Having failed to so pursue his claim, the junior party should not be allowed to now renew its claim to the detriment of others such as Boone.

The cases cited by Hyatt in support of its position are distinguishable and are not controlling. Those cases, *Donohue, supra, Russell, supra, Craig, supra*, and *Herr, supra,* did not involve a dispute between parties such as we have in the present proceeding, but were simply *ex parte* cases having new records and involving the application for government grant of statutory rights dependent for issuance on compliance with stated conditions. The party Hyatt failed to put its best foot forward in the '253 applicaiton to its own peril and should not now be allowed to stomp on the intervening rights of another such as Boone in view of that failure. Furthermore, the above cases did not involve the decision of a specific question under 35 U.S.C. § 112, such as whether the disclosure of an application is inoperative, as in *Hemphill, supra* and *Lawson, supra* or whether claims are supported by the disclosure of an application as in *Szwarc, supra* or whether a disclosure is enabling as in *Hyatt, supra.*

PATE, *Administrative Patent Judge.*

I write separately, on the issue of collateral estoppel/*res judicata*. The issue, as I understand it, is much simpler than has been outlined by my fellow panel members.

In his concurring opinion in *In re Herr*, 377 F.2d 610, 619, 153 USPQ 548, 555 (CCPA 1967) Judge Rich expressly addresses this precise situation when he states,

> Where an appellate court has decided a *specific* question, for example that the disclosure of an application is inoperative *or that claims are not supported by the disclosure of an application within the meaning of 35 U.S.C. § 112*, the doctrine of collateral estoppel should normally prevent relitigation of that issue (citations omitted; second emphasis supplied).

However, Judge Rich then continues stating,

> The broader all-inclusive issue of patentability of claims, however, depends on numerous factors which may be found in the *words of the claims themselves*, in the disclosure of the specification, in extraneous evidence, in factor relating to the admissibility of evidence and possibly elsewhere (emphasis supplied).

Thus, while the specific issue of 35 U.S.C. § 112 first paragraph support has been decided by the Federal Circuit, the claims of party Hyatt are not now literally the same as the claims on appeal in the decided case. For this simple reason, it is my view that estoppel should not apply in this instance.

LEE, *Administrative Patent Judge.*

I agree with Judge Urynowitz's opinion in full, except for its conclusion and discussions in the section applying *res judicata*/collateral estoppel against Hyatt to preclude Hyatt from arguing enablement with respect to his priority application.

In my view, Hyatt is not estopped from arguing that the specification of his earlier '881 application is enabling with respect to an embodiment within the count. However, the merits of the enablement issue need not be reached because the specification of the '881 priority application clearly lacks adequate written description for an embodiment within the count.

Judge Rich's concurring opinion in *In re Herr*, 377 F.2d 610, 619, 153 USPQ 548, 555 (CCPA 1967) is not fully understood insofar as its distinguishes "[t]he broader, all inclusive issue of patentability of claims" from "a *specific* question" on whether a disclosure is inoperative or whether the claims are unsupported by the disclosure within the meaning of 35 U.S.C. § 112, first paragraph. The former, according to Judge Rich, depends on numerous factors which may be found in the words of the claims themselves, in the disclosures of the specification, in extraneous evidence, and in factors relating to the admissibility of evidence. But I see the inadequate written description issue also as involving all-inclusive questions which may turn on many underlying factors including changes to the claims and the substance and admissibility of extrinsic evidence.

If the claims are amended, that will certainly affect the determination on the adequacy of written description support in the specification. The same is true if declarations from experts or people of ordinary skill in the art are submitted and considered. A different body of extrinsic evidence establishes a different evidentiary record. Moreover, if claim language is alternatively interpreted, that will also affect any analysis on the adequacy of written descriptive support in the specification. We know that claim interpretation depends on a multitude of different factors including extrinsic evidence such as expert testimony. *Hormone Research Foundation, Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1562, 15 USPQ2d 1039, 1043 (Fed. Cir. 1990), *cert. dismissed*, 499 U.S. 955 (1991). If written

description is a "specific question," I see no reason why patentability over prior art is not, and if patentability over prior art is not a "specific question," I see no reason why written description is.

In contrast, what is crystal clear from Judge Rich's concurring opinion in *In re Herr*, *supra*, is that there are important policy reasons for allowing an applicant attempting to secure the issuance of a patent to come back with new evidence in continuing applications to try to meet the requirements law.

In *In re Herr*, 377 F.2d 615-16, 153 USPQ at 552-53, Judge Rich stated:

> Res judicata is a judicial doctrine the purpose of which is to settle *disputes* and put an end to *litigation*, enforcing ultimate repose. This is a matter of public policy, and a good one when applied to the situations for which it was designed. But the ex parte prosecution of patent applications cannot properly be characterized as either dispute or litigation. Moreover, there is another public interest to be considered, inherent in the patent laws, which is to bring *patentable* inventions into the open through *granting* patents on them . . . .
>
> . . . .
>
> . . . Allowing and entertaining an application must be distinguished [from repeated litigation of the same issues]. The Patent Office has to entertain every application. Allowance depends on compliance with the statutory prerequisites. The second application may comply whereas the first did not. If I apply for a driver's license, I have to pass eye and driving tests. I may fail. If I come back with glasses and the requisite skill, should my new application be entertained and allowed? Or am I forever barred because I appealed the first denial? Yes, there is every reason why the first determination should not

> be conclusive. The applicant may be bringing the required statutory quid pro quo which he did not bring before. Why not ten or twenty? To be realistic, why not two or three? Is this not authorized practice? The applications will stop when the application offers nothing new and the applicant is merely repeating himself, whereupon the Office will be justified in merely denying them *for the same reasons as previously stated.* No applicant will keep this up very long (emphasis in original).

Judge Rich's concurring opinion in *In re Herr*, 377 F.2d at 619, 153 USPQ at 555, concludes with this statement:

> In the administrative process of patent granting, including appellate review of rejections, *estoppel by prior judgment should be applied only in the clearest cases of attempted reargument of previously decided issues* (emphasis added).

Even in *In re Herr*, *supra*, the CCPA held that collateral estoppel did not apply in the factual circumstances there.

I see no proper basis for singling out 35 U.S.C. § 112, first paragraph, issues as those for which *res judicata* and collateral estoppel principles will automatically successfully preclude a revisiting of the issues on the basis of a different evidentiary record.

Hyatt's submission in this interference of substantial extrinsic evidence not previously presented before the Patent and Trademark Office more than amply demonstrates that this is not one of those "clear cases" of mere reargument referred to by Judge Rich in *In re Herr*, *supra*. The "reargument" contemplated by Judge Rich means a state of affairs wherein the applicant offers up nothing meaningfully new in the evidence to be considered by the Patent and Trademark Office.

Note also that in Hyatt's involved application, the Primary Examiner rejected all of Hyatt claims on the ground that the disclosure did not enable the making of a com-

puter on a single chip (Office Action dated July 12, 1989). In response to the rejection, Hyatt submitted arguments as well as his own affidavit (Paper No. 10 in Hyatt's involved patent) as evidence that the disclosure was enabling at the time of filing of the '881 application based on the knowledge of one with ordinary skill in the art in November 1970. Thereafter, the examiner withdrew outstanding rejections and allowed all of Hyatt's claims.

Thus, during prosecution of Hyatt's involved patent and upon allowance of his claims, Hyatt had no further need to provide additional extrinsic evidence of the type he is presenting now. Had the examiner not allowed Hyatt's claims, Hyatt may well have previously presented in *ex parte* prosecution the evidence now he seeks to present. It was the PTO who made it unnecessary for Hyatt to present additional evidence during examination.

The Court of Customs and Patent Appeals has held that *res judicata* does not have its usual impact when considering *ex parte* appeals and that the public interest in granting valid patents outweighs the public interest underlying collateral estoppel and *res judicata*. *See, e.g., In re Oelrich*, 666 F.2d 578, 580 n.2, 212 USPQ 323, 325 n.2 (CCPA 1981). While this case is an *inter parte* interference, it is the *ex parte* or *inter parte* nature of the prior decision on the basis of which a later argument would be estopped which matters. *See, e.g., In re Clark*, 522 F.2d 623, 187 USPQ 209 (CCPA 1975); *In re Pritchard*, 463 F.2d 1359, 175 USPQ 17 (CCPA 1972); *In re Katz*, 467 F.2d 939, 167 USPQ 487 (CCPA 1970).

The CCPA decisions in *In re Donohoe*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985), *In re Russell*, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971), and *In re Craig*, 411 F.2d 1333, 162 USPQ 157 (CCPA 1969), which all held that estoppel did not apply, cannot be distinguished on the basis that they involve an *ex parte* situation whereas this case does not. Just as in those cases,

the prior decision involved here is an *ex parte* decision in the course of patent examination.

Judgment

Judgment as to the subject matter of count 1 is hereby awarded against Gilbert P. Hyatt, the junior party. The party Hyatt is not entitled to its involved patent with claims 1-35.

Judgment as to the subject matter of count 1 is hereby awarded against Gary W. Boone, the senior party. The party Boone is not entitled to a patent with its claims 83-98.

/s/ Stanley M. Urynowicz, Jr.
STANLEY M. URYNOWICZ, JR.
Administrative Patent Judge

/s/ William F. Pate, III
WILLIAM F. PATE, III
Administrative Patent Judge

/s/ Jameson Lee
JAMESON LEE
Administrative Patent Judge

BOARD OF PATENT APPEALS
AND INTERFERENCES

[DoC Logo] Paper No. 23

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Address:

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Patentee Hyatt

Serial No. 07/209,115

Filed 06/17/88, now Patent No. 4,942,516, granted 07/17/90

FOR: SINGLE CHIP INTEGRATED CIRCUIT COMPUTER ARCHITECTURE

Accorded Benefit of: U.S. Application Nos. 06/223,959, filed 01/12/81; 05/860,253, filed 12/14/77; 05/860,-256, filed 12/14/77, now Patent No. 4,829,419, granted 05/09/89; and 05/860,258, filed 12/14/77

REDECLARATION

In view of the Board decision of even date herewith, this proceeding is redeclared by adding Hyatt claims 4, 5, 10-14, 17-24 and 32 as corresponding claims. The claims of the parties which correspond to count 1 are:

Hyatt Claims 1-35
Boone Claims 83-98

/s/ Stanley M. Urynowicz, Jr.
STANLEY M. URYNOWICZ, JR.
Administrative Patent Judge
(703) 603-3312

[DoC Logo] Paper No. 27

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Applicant Boone

Serial No. 07/473,541

Filed 02/01/90

FOR: VARIABLE FUNCTION PROGRAMMED SYSTEM

Accorded Benefit of: U.S. Application Nos. 07/325,703, filed 03/20/89; 07/097,489, filed 09/15/87; 06/915,-857, filed 10/06/86; 06/750,647, filed 06/28/85; 06/604,404, filed 04/27/84; 06/002,815, filed 01/12/79; 05/856,932, filed 12/02/77, now Patent No. 4,242,675, granted 12/30/80; 05/420,999, filed 12/03/73; and 05/163,565, filed 07/19/71

REDECLARATION

In view of the Board decision of even date herewith, this proceeding is redeclared by adding Hyatt claims 4, 5, 10-14, 17-24 and 32 as corresponding claims. The claims of the parties which correspond to count 1 are:

Hyatt Claims 1-35

Boone Claims 83-98

/s/ Stanley M. Urynowicz, Jr.
STANLEY M. URYNOWICZ, JR.
Administrative Patent Judge
(703) 603-3312

APPENDIX F

Paper No. 271

UNITED STATES PATENT
AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

GILBERT P. HYATT
Junior Party,[1]

v.

GARY W. BOONE
Senior Party.[2]

Interference No. 102,598

---

[1] Patent No. 4,942,516, granted July 17, 1990, based on Application 07/209,115, filed June 17, 1988. Accorded the benefit of U.S. Applications 06/223,959 filed January 12, 1981, 05/860,253 filed December 14, 1977, 05/860,256 filed December 14, 1977, now Patent No. 4,829,419 granted May 9, 1989 and 05/860,258 filed December 14, 1977.

[2] Application 07/473,541, filed February 1, 1990. Accorded the benefit of U.S. Applications 07/325,703 filed March 20, 1989, 07/097,489 filed September 15, 1987, 06/915,857 filed October 6, 1986, 06/750,647 filed June 28, 1985, 06/604,404 filed April 27, 1984, 06/002,815 filed January 12, 1979, 05/856,932 filed December 2, 1977, now Patent No. 4,242,675 granted December 30, 1980, 05/420,999 filed December 3, 1973 and 05/163,565 filed July 19, 1971.

Before URYNOWICZ, PATE and LEE, *Administrative Patent Judges.*

URYNOWICZ, *Administrative Patent Judge.*

RECONSIDERATION

The party Boone has filed a request for reconsideration under 37 CFR §1.658(b) (Paper No. 267) of our decision at final hearing of September 19, 1995 (Paper No. 263). The party Hyatt stands opposed (Paper No. 269).

Boone contends that the form of the judgment should be revised to reflect the Board's conclusions as stated in the opinion portion of the decision at final hearing. The senior party argues to the effect that judgment against Boone should be vacated and requests that the form of the judgment as to it be changed to read as follows:

> Priority as to the subject matter of count 1 is hereby awarded to Gary W. Boone, the senior party. Because the party Boone's application will be examined only as a SIR application, no judgment is awarded as to the patentability of Boone's involved claims.[3]

It is alleged that without a statement in the judgment awarding priority in Boone's favor, the *ex parte* examiner handling Boone's application will not have clear and authoritative guidance establishing that the statutory requirement of a final determination of priority has been met.

We find no merit to the argument of Boone. With respect to the last contention above, 37 CFR §1.658(a) merely provides that in a decision entering judgment as to a count, the judgment shall state whether or not each party is entitled to a patent containing the claims in the party's patent or application which corresponds to the

---

[3] SIR is an abbreviation for Statutory Invention Registration.

count. The rule does not require a judgment to state that priority of invention as to the subject matter of a count is awarded to a party where the Board found priority of invention as to that party in the opinion portion of its decision.

In its opinion, the Board did in fact state to the effect that as between Hyatt and Boone, Boone is the prior inventor. That statement appears as the first two sentences of the paragraph bridging pages 23 and 24 of our decision. We reiterate that Boone is presumed to be the prior inventor of the subject matter in issue.

As noted above, 37 CFR §1.658(a) provides that a judgment as to a count shall state whether or not each party is entitled to a patent containing the claims in the party's patent or application which correspond to the count. Whereas Boone has elected to obtain a SIR, it was proper under the rule to indicate in our judgment that Boone is not entitled to a patent with its claims 83-98. The only other possibility was for the Board to state in the judgment that Boone is entitled to a patent with its claims 83-98. Having elected a SIR, Boone is not so entitled.

Since Boone is not entitled to a patent with its involved claims, it logically follows that judgment be entered against, as opposed to for, Boone.

The request for reconsideration is granted to the extent of our above reconsideration but is denied as to making any change in our final decision.

/s/ Stanley M. Urynowicz, Jr.
STANLEY M. URYNOWICZ, JR.
Administrative Patent Judge

/s/ William F. Pate, III
WILLIAM F. PATE, III
Administrative Patent Judge

/s/ Jameson Lee
JAMESON LEE
Administrative Patent Judge

BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 272

UNITED STATES PATENT
AND TRADEMARK OFFICE

BEFORE THE COMMISSIONERS OF PATENTS
AND TRADEMARKS

GILBERT P. HYATT
Junior Party,

v.

GARY W. BOONE
Senior Party.

Interference No. 102,598

DECISION ON PETITION

Boone petitions (Paper No. 266) seeking to invoke the supervisory authority of the Commissioner "over the procedures to be followed in patent interferences involving applications for statutory invention registration (SIRs)."

Upon review of the petition, what Boone actually seeks is review of the judgment of the Board. Alternatively, the relief sought by Boone is a rehearing. However, review of a judgment of a the Board is by way of appeal (35 U.S.C. § 141) or civil action (35 U.S.C. § 146). Furthermore, only the Board is authorized to grant a rehearing. 35 U.S.C. § 7(b), last sentence. Hence, a petition cannot be used as a vehicle for seeking an amendment of the Board's judgment or as a vehicle for a petition for rehearing.

The interference involves a patent of Hyatt and a patent application of Boone. At some point during the pendency of the Boone application, Boone indicated that it was his intention to convert the Boone application into a SIR.

If an interference is declared with respect to an application sought to be converted into a SIR, a SIR may not be published unless the issue of priority of invention is finally determined in favor of the applicant. 35 U.S.C. § 157(a), last sentence.

In entering judgment in this interference, the panel determined that Hyatt was not entitled to a patent because the claims of the Hyatt patent were not patentable. The panel also determined that Boone was not entitled to a patent, because of Boone's explicit desire to have the application published as a SIR. Hence, judgment was entered against both parties, that is, the panel determined that neither party was entitled to a patent containing claims corresponding to the count. However, on the issue of priority of invention, the panel made it absolutely clear in its opinion in support of its original decision (Paper No. 263, page 23) that Boone is "considered to be the prior inventor of the subject matter in issue," i.e., the subject matter of the count. At the time the interference was declared, a presumption existed that Boone was the prior inventor vis-a-vis Hyatt, because Boone was designated as the senior party. 37 CFR § 1.657(a). Nothing which happened during the interference changed the presumption. *Compare Oka v. Youssefyeh,* 849 F.2d 581, 584, 7 USPQ2d 1169, 1172, col. 1, last paragraph (Fed. Cir. 1988).

In light of the discussion above, it is manifest that the panel has determined the issue of priority of invention in favor of Boone. Hence, there is nothing in the last sentence of 35 U.S.C. § 157(a) which precludes publication of the Boone application involved in the interference as a SIR.

The petition is *denied.*

/s/ Bruce H. Stoner, Jr.
BRUCE H. STONER, JR.
Chief Administrative Patent Judge

Supreme Court, U.S.
FILED
DEC 28 1998
OFFICE OF THE CLERK

No. 98-856

IN THE
Supreme Court of the United States
OCTOBER TERM, 1998

GILBERT P. HYATT,
Petitioner,

v.

GARY W. BOONE,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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QUESTION PRESENTED

The question presented in the petition was not argued or decided below. It is most accurately stated as follows:

Whether 35 U.S.C. § 112, ¶ 1, which by its terms requires a patent applicant to provide a written description of both "the invention," as well as "the manner and process of making and using it" requires a written description both (i) to show that the applicant was in possession of the invention, and (ii) to enable a skilled artisan to make and use the invention.

PARTIES TO THE PROCEEDINGS

All parties in the court and agency below and here are listed in the caption. For the Court's information, the real party in interest for respondent is Texas Instruments Incorporated, which is the assignee of Boone's application-in-interference.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1998

No. 98-856

GILBERT P. HYATT,

Petitioner,

v.

GARY W. BOONE,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

---

RESPONDENT'S BRIEF IN OPPOSITION

This case involved the factbound question of who first invented a "computer on a chip," a device incorporating all the essential parts of a computer on a single integrated circuit chip. Petitioner Hyatt alleged he was the first inventor by virtue of a patent application he filed on December 28, 1970. Respondent Boone contended, the Board of Patent Appeals and Interferences ("Board") found, and the Court of Appeals for the Federal Circuit affirmed, that Boone, and not Hyatt, was the first inventor based on Boone's possession of the invention as of July 19, 1971. In reaching this finding, the Board and the Federal Circuit determined that Hyatt did not describe the invention now at issue in his 1970 patent application, but instead first described it in an application he filed in 1977 with added language.

This dispute was resolved in Boone's favor by the Board based upon its evaluation of a voluminous record of patent

applications, prosecution histories, documentary evidence and testimony. The Court of Appeals affirmed the Board's findings as not clearly erroneous, applying the consistent, logical, and statutorily grounded precedent of both the Federal Circuit and its predecessor, the United States Court of Customs and Patent Appeals ("CCPA"). Hyatt's petition seeks review of the Federal Circuit's decision upon a legal basis he never asserted before the Federal Circuit or at any other stage of this proceeding and which has never been addressed or ruled upon by any tribunal in this case. There is no basis for this Court's review.

STATEMENT

The background of this case is as follows:

1. *The Origin of This Case*

This case arose out of a patent interference proceeding in the Patent and Trademark Office ("PTO") to determine priority of invention of the computer on a chip. Such devices, commonly known as single-chip microcontrollers, execute computer programs permanently stored on the chip to duplicate functions that previously would have required custom-designed, hard-wired electronic logic circuits. The invention at issue is set forth in claim 29 of U.S. Patent No. 4,942,516 ("the '516 patent") issued to Hyatt on July 19, 1990. That claim states:

> A computer on a chip comprising:
>
> an integrated circuit chip having a computer implemented thereon;
>
> an integrated circuit main memory storing computer instructions, wherein said integrated circuit main memory is included on said integrated circuit chip;
>
> an integrated circuit operand memory storing operands, wherein said integrated circuit operand memory is included on said integrated circuit chip; and

> an integrated circuit processing circuit processing the operands stored by said integrated circuit operand memory in response to the instructions stored by said integrated circuit main memory, wherein said processing circuit is included on said integrated circuit chip.

Pet. App. 3a.

Shortly after issuance of the '516 patent, Boone provoked an interference proceeding by copying this claim into his patent application, Application No. 07/473,541 (the '541 application). *Id.* In the interference proceeding both parties claimed they were entitled to priority for the invention based upon earlier-filed patent applications pursuant to 35 U.S.C. § 120. On March 27, 1991, a Declaration of Interference was issued by the Board, according Boone an effective filing date of July 19, 1971 and Hyatt an effective filing date of December 14, 1977. Pet. App. 24a. Hyatt then moved to be accorded benefit of an earlier patent application he filed on December 28, 1970, Application No. 05/101,881. Pet. App. 25a.

Hyatt's 1970 patent application concerned a *multiple chip* "data processing system," described as follows in the "Summary of the Invention" section of the application:

> A general purpose data processor is provided which is fully implementable with integrated circuits. Thus, an integrated circuit in read-only memory (ROM) provides an example of a capacity not found in present data processing systems. Other examples are a random access memory (RAM) and other types of flip flop memories used alone or in combinations of integrated circuit memories for this data processing system.

(A206)[1] According to the 1970 patent application, a basic concept of the invention was to provide a "physically distributed, operatively dispersed system." (A212, A215-16) Thus, Hyatt's 1970 patent application described a

[1] "A" refers to the Appendix filed in the Court of Appeals.

computer system made up of *multiple* integrated circuits mounted on *multiple* printed circuit boards:

> The data processor is built from series SN7400 integrated circuits manufactured by Texas Instuments, Inc., which are located on a series of printed circuit boards. These printed circuit boards plug into a Mother board which provides necessary interconnections between the terminals of the printed circuit boards.

(A234) The application illustrated the invention with schematic diagrams of 12 different printed circuit boards on which the various chips were mounted (A207-08; A331-45) and provided a detailed description of these boards in a section entitled "Schematic Diagrams." (A280-88)

The main embodiment of the computer described in the body of Hyatt's 1970 patent application used a magnetic core memory to store data and computer instructions (A214; A326 (Figure 1)), although the application mentioned alternative embodiments in which the core memory was replaced with various types of integrated circuit memory. (A210) Thus, the application noted that the computer could be built entirely of integrated circuits:

> The architecture of the data processor 12 lends itself to a fully integrated circuit computer mainframe where all of the logic is implemented with integrated circuits in a conventional manner and additionally includes an integrated circuit scratch pad memory (SPM). Further, this data processor has the architecture to use an integrated circuit read-only memory (ROM) in place of or in addition to the core memory 30 providing a data processor that is construed wholly of integrated circuit components.

(A234)

Significantly, all the computer embodiments described in the body of Hyatt's 1970 patent application consisted of *multiple* integrated circuits mounted on *multiple* printed circuit boards. Nowhere did the body of this application

mention placing all the functions of a computer on a single integrated circuit chip. In view of these exclusively multiple-chip embodiments, one worker in the field in 1970 (Stanford University Professor of Electrical Engineering Michael J. Flynn) testified in the interference that the application described what was then a conventional minicomputer. (A1566-68)

In view of the multi-chip character of the description in the body of Hyatt's 1970 patent application, Hyatt's argument below—that the application described a complete computer on a *single chip*—was based exclusively on claim 40 of the application, as originally filed:

> 40. An electronic data processing system including read only memory means, alterable memory means and program means, said system being implemented on a single integrated circuit chip.

Pet. App. 6a.[2] Significantly, however, Hyatt testified in the interference that he had neither the experience nor the knowledge, and thus could not possibly have disclosed in his 1970 patent application, how to build a single-chip computer. Rather, "[his] plan had always been to take [his] single chip computer design to a company that built custom integrated circuits and let that company build [his] computer using one of their standard processes selected by them." Pet. App. 36a.

Hence, the factual question presented by Hyatt in the court and agency below was whether claim 40 of Hyatt's 1970 patent application sufficiently described the computer-on-a-chip invention defined in the interference such that Hyatt's far more specific and detailed 1990 patent should be deemed to have an effective filing date of December 28, 1970.

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[2] All of the "workings of a data processing system" described by Hyatt (Pet. 7-8), were multi-chip embodiments that, as will be discussed below, the Board ruled could not properly be combined with the single-chip device described in claim 40 of Hyatt's 1970 '881 application.

2. *The Statutory Framework*

Under 35 U.S.C. § 120, a patent applicant may obtain the benefit of a prior patent application under certain circumstances:

> An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application filed in the United States . . . by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

35 U.S.C. § 120.

Thus, by the express terms of Section 120, an application must comply with the first paragraph of 35 U.S.C. § 112, which states:

> The specification shall contain a written description *of the invention,* and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112, ¶ 1 (emphasis added). The Federal Circuit, and its predecessor the CCPA, have consistently held that this paragraph contains three separate requirements for the specification. *First,* the patent must contain a written description "of the invention" such that the applicant conveys "with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention.* The invention is, for purposes of the 'written description' inquiry, *whatever is now*

claimed." *Vas-Cath, Inc. v. Mahurkar,* 935 F.2d 1555, 1563 (Fed. Cir. 1991) (emphasis added); *see also Lockwood v. American Airlines,* 107 F.3d 1565, 1572 (Fed. Cir. 1997); *In re Alton,* 76 F.3d 1168, 1172 (Fed. Cir. 1996). *Second,* the written description must not only show possession of the "invention"; it must also disclose " 'the manner and process of making and using it, in such full, clear, concise, and exact terms as to *enable* any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.' " To fulfill this enablement requirement, "a patent must give persons of ordinary skill in the relevant art enough information to practice the invention disclosed in the specification without undue experimentation." *Alton,* 76 F.3d at 1172 & n.5 (emphasis added); *see Vas-Cath,* 935 F.2d at 1563. *Third,* the written description must " 'set forth the best mode contemplated by the inventor of carrying out his invention.' " *See Alton,* 76 F.3d at 1172 & n.5 (noting that "[t]he best mode requirement mandates that the inventor disclose the best mode known to him or her at the time the patent application is filed"). Only the first two of these three requirements—"written description" and "enablement"—are relevant to this case.

3. *The 1988 Federal Circuit Decision*

On December 14, 1977, apparently cognizant that supporting any claim to a single-chip computer would require language in his patent application that would link its body's description of the circuitry of multi-chip computers with the idea of implementation on a single chip, Hyatt filed Continuation-In-Part Application No. 05/860,253. Hyatt's 1977 application *added* for the first time the linking language italicized below to that of his 1970 application:

> The basic architecture of this data processor will permit an integrated circuit memory, such as a read-only memory (ROM), or a random-access memory (RAM) or flip-flop type memory to be substituted

> for the core memory 30 to provide a completely integrated circuit computer which might be called a monolithic computer. *This monolithic data processor can be implemented on a single integrated circuit chip which can include a read only memory, an alterable memory, and program execution circuitry on the same chip.*

(A3625); *compare* A3625 (1977 application) *with* A210 (1970 application).

With his 1977 application, Hyatt presented various claims directed to a single-chip computer based on his 1970 application, which were rejected. (A3500-10; A3513-34) Although the patent examiner was dubious that claim 40 of the 1970 application disclosed a single-chip computer at all (A3562), he chose instead to focus in his Answer on his assertion that Hyatt's application did not *enable* the making of a single-chip computer as of the filing date of Hyatt's 1970 application. (A3538-39) The Board affirmed the examiner's rejections on that basis. (A3564-75)

Hyatt appealed the Board's decision to the Federal Circuit. Hyatt's patent claims involved in that appeal claimed the same invention as involved in this case, albeit with minor variations in language.[3] After reviewing the evidence relied on by Hyatt and the Board concerning the enablement issue,[4] the Court held that Hyatt had failed to establish that his 1970 application was enabling for a single-chip computer—the exact issue in the present case:

> Appellant has not come close to presenting sufficient evidence to make a persuasive case that a routineer in the integrated circuit art in 1970, presented with appellant's disclosure and supplementing it with what was well known in the art, could have implemented

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[3] *Compare* A3953-68 (claims on appeal in 1988) *with* Pet. App. 3a (claim at issue here).

[4] *See, e.g.*, A3844-59; A3901-10; A3925-41.

> appellant's computer on a single chip without undue experimentation.

In re Hyatt, No. 87-1597 (Fed. Cir. June 9, 1988) at 9 (A1260). *See also* Pet. App. 40a. Accordingly, the Court affirmed the rejection.

In subsequent prosecution of a continuation application, Hyatt obtained allowance by the PTO of essentially the same claims by submitting essentially the same evidence of enablement, augmented by his own declaration that he believed a single-chip computer could have been built in 1970. (A3987-93; A3972-76; A3996-4006) Even so, before the Board in the present case, Hyatt himself stated that the Federal Circuit's 1988 enablement decision "can now be considered to be law of the case herein and this can be considered to be res judicata herein." Pet. App. 41a (quotation omitted).

4. *The Board's Decision in the Present Case*

With regard to Hyatt's 1970 patent application at issue here, Hyatt did not argue that no written description was required, but instead, urged that his 1970 patent application met that standard. Hyatt argued to the Board that the single-chip electronic data processing system described in claim 40 should be combined with the multi-chip embodiments described in the body of his application. The Board, however, rejected this argument, instead making factual findings that the single-chip system of claim 40 did not possess the attributes required by claim 29 of the 1990 '516 patent. *First*, the Board found that claim 40's "read only memory means" did not necessarily constitute the "main memory storing computer instructions" required by claim 29. Pet. App. 33a. *Second*, the Board found that claim 40's "alternate memory means" did not necessarily constitute the "operand memory storing operands" required by claim 29. Pet. App. 33a. *Third*, and perhaps most importantly, the Board found that claim 40's "program means" *is not* the "processing circuit" required by

claim 29, nor does it process operands in response to stored instructions. Pet. App. 33a-34a. The Board emphasized that the 1970 application's distinct use of the terms "program" and "program means" elsewhere in its specification "*makes it clear that the 'program means' is not a processing circuit.*" Pet. App. 34a (emphasis added).[5] The Board also focused upon the testimony of certain witnesses, concluding that "if 'program means' can be a circuit (processor) that responds to a program as indicated by the above witnesses, it is *at least as likely* that it can be a memory that merely stores a program without processing operands." Pet. App. 34a (emphasis added). Accordingly, the Board held that "Hyatt's [1970] '881 application fails to meet the written description requirement of 35 U.S.C. § 112, first paragraph, and . . . Hyatt is not entitled to benefits of either of [his] prior applications for that reason." Pet. App. 33a.

5. ***The Federal Circuit's Decision Below***

On appeal, the Federal Circuit affirmed the Board's decision, holding that "[t]he Board did not clearly err" in ruling that Hyatt was entitled the benefit of the filing date of his 1970 '881 application. Pet. App 5a-11a. In doing so, the court painstakingly analyzed the factual findings of the Board. The court noted that, as the Board had found, except for claim 40, "[t]here is no other mention in the '881 [1970] specification of a single integrated circuit chip, although other electronic data systems are extensively described." Pet. App. 6a. The court of appeals emphasized the Board's factual finding "that the parts of the written description that are lacking from claim 40 are not provided elsewhere in the '881 specification whose systems and circuitry neither describe nor suggest a computer on a single chip." Pet. App. 7a. The court also

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[5] Consequently, petitioner is entirely incorrect when he states that "[t]he Board in this case did not dispute that the written description in the [1970] application could have *included* the invention in issue." Pet. 27 n.21.

carefully analyzed and affirmed the Board's findings that claim 40's (1) "read only memory means," (2) "alterable memory means" and (3) "program means" did not correspond to the requisite language in claim 29 of Hyatt's 1990 '516 patent. Pet. App. 6a-7a.

The court did not, however, address the argument Hyatt now urges upon this Court—that Section 112, paragraph 1 contains no separate and independent "written description" and "enablement" requirements. There was good reason for the Federal Circuit not to have addressed that argument: it was not raised by Hyatt either in the Federal Circuit or before the Board. To be sure, the Court of Appeals did find that the Board had applied the correct standard for its analysis—that the specification must "necessarily" describe the entire subject matter of the claim. Pet. App. 8a-9a (citing *Martin v. Mayer,* 823 F.2d 500, 505 (Fed. Cir. 1987); *Lockwood v. American Airlines, Inc.,* 107 F.3d at 1571-72; *Jepson v. Coleman,* 314 F.2d 533, 536 (CCPA 1963)). The court addressed and rejected Hyatt's argument that other Federal Circuit cases articulated a more lenient standard of "reasonably conveys," rather than "necessarily possesses," the invention, finding that regardless of the words used to describe the applicable test, "[w]e do not view these various expressions as setting divergent standards for compliance with § 112. In all cases, the purpose of the description requirement is 'to ensure that the inventor had possession as of the filing date of the application relied on, of the specific subject matter later claimed by him.'" Pet. App. 10a (quoting *In re Edwards,* 568 F.2d 1349, 1351-52 (CCPA 1978)).

The Federal Circuit concluded:

> The Board did not clearly err in finding that Hyatt did not establish in the [1970] '881 application's written description that he possessed the entire subject matter of the count. This finding comports with the criterion not only of *whether the description conveyed to the artisan the specific subject matter of the*

> *count*, but also of whether the applicant established that this was the necessary construction of that description. The written description must include the limitations of the count with sufficient clarity and specificity that "persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations."

Pet. App. 10a-11a (quoting *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976)) (emphasis added).[6]

REASONS FOR DENYING THE WRIT

Petitioner has shown no basis for review. The question presented by the petition was never raised in or ruled upon by the Federal Circuit below or any other tribunal in this case. The Court of Appeal's decision was instead based upon its agreement with the Board that petitioner had failed to establish his case *as a matter of fact*.

In sustaining the factual basis for the Board's ruling, the Federal Circuit concluded that the Board had applied the correct legal standards for its analysis. Those standards, seriously misconstrued by petitioner, are demonstrably based upon the plain text of the statute (35 U.S.C. § 112, ¶ 1). Petitioner alleges no conflict in authority, and in fact, the legal standards applied by the Federal Circuit in this case have been consistently applied by that court and its predecessor, the CCPA.

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[6] Although presented to the Federal Circuit on Boone's cross-appeal, *see* Brief for Cross-Appellant Gary W. Boone, Nos. 96-1514, 1515 (Fed. Cir., filed Dec. 24, 1996) at 26-39, the court did not address the alternative argument that Hyatt's 1970 application was invalid based upon the collateral estoppel effect of the Federal Circuit's previous (1988) ruling that the same claims at issue here ran afoul of the "enablement" requirement of Section 112. The Board did address this issue, but did not reach a consensus regarding its proper resolution, with each of the three Administrative Judges writing and analyzing this issue separately. Pet. App. 40a-50a.

Finally, and in any event, this case would provide a particularly poor vehicle for this Court's review. For one, the Federal Circuit's ruling was dependent upon the facts found by the Board, which, as the Federal Circuit has noted in other cases under Section 112, ¶ 1, causes such cases to have limited precedential value. For another, this case is further complicated by the fact that the record discloses an alternative ground for affirmance, presented to the court below but not reached. Certiorari should be denied.

I. THE QUESTION PRESENTED BY PETITIONER WAS NOT RAISED OR RULED UPON BELOW

Petitioner seeks review of the following question: "Whether Section 112, ¶ 1 requires a patent applicant to submit a written description of his invention that, *in addition to enabling one skilled in the art to make and use the invention,* 'necessarily' shows 'possession' of the invention." Pet. (i) (emphasis added). This question—which focuses upon whether Section 112, ¶ 1 has *separate* "written description" and "enablement" requirements (*see* Pet. 11-27 (arguing entirely for the elimination of such separate requirements))—was not raised before, presented to or ruled upon by the Federal Circuit below or any other tribunal in this case. Indeed, petitioner's own statement of the issues in the Federal Circuit urged that an "express description" requirement was "proper," although disputing the content of that requirement. *See* Brief for Appellant Gilbert P. Hyatt, Nos. 96-1514, 1515 (Fed. Cir., filed Nov. 4, 1996) at 1, Resp. App. 15a-16a; *see also* Gilbert Hyatt's Petition For Rehearing and Suggestion for Rehearing In Banc, Nos. 96-1514, 1515 (Fed. Cir., filed July 15, 1998) at 1-14, Resp. App. 1a-14a; Reply Brief for Appellant Gilbert P. Hyatt, Nos. 96-1514, 1515 (Fed. Cir., filed Feb. 19, 1997).[7]

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[7] The questions presented in the Court of Appeals were:

[1.] Whether the Board committed reversible error in denying Hyatt benefit of the '881 application by deciding that the

This Court routinely refuses to review such questions not raised below. *See, e.g., Delta Airlines v. August*, 450

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application failed under 35 U.S.C. § 112 to describe a "computer on a chip" as defined by the Count.

A. Whether the Board committed reversible error by looking *only* at original Claim 40, failing to consider the *whole* '881 application.

B. Whether the Board committed reversible error by improperly applying the "necessary" test for an inherent description *instead of the proper "reasonably conveys" test for an express description.*

[2.] Whether the Board committed reversible error in giving Boone benefit of his 1971 application in view of at least two breaks in his chain of priority applications.

Resp. App. 15a-16a (emphasis added). Hyatt's Petition for Rehearing and Suggestion of Rehearing In Banc likewise urged the adoption of a *lesser* "reasonably conveys" test for the written description, Resp. App. 1a-14a; at no time, though, did petitioner ever advocate the *elimination* of that requirement.

In any event, the Federal Circuit's rejection of petitioner's argument below was correct since that court "d[id] not view these various expressions" such as "reasonably conveys" and "necessarily discloses" "as setting divergent standards for compliance with § 112." Pet. App. 10a. And even were there a difference, the "necessarily discloses" standard would more aptly state the proper scope of limitation upon the "written description" requirement, for to insure that the "inventor had possession, as of the filing date," "the written description must include all of the limitations of the interference count, or the applicant must show that any absent text is necessarily comprehended in the description provided and would have been so understood at the time the patent application was filed." Pet. App. 10a. Further, the "necessarily discloses" standard would be more precise than an amorphous "reasonably conveys" standard. *See Lockwood*, 107 F.3d at 1565 (disclosure requiring "speculat[ion] as to modifications that the inventor might have envisioned, but failed to disclose" is insufficient under § 112). Finally, contrary to petitioner's unsupported suggestion, Pet. 20-21, the "necessarily discloses" standard would not work "to resolve all doubts against the inventor." Rather, the reality would be that as long as the inventor, expert in his or her own field, would fully and accurately describe the invention, the disclosure would likely be found sufficient. "The primary consideration is factual and depends

U.S. 346, 362 (1981) (refusing to consider question "presented in defendant's petition for certiorari" because "that question was not raised in the Court of Appeals and is not properly before us"). *See also Sisson v. Ruby*, 497 U.S. 358, 359 n.1 (1990); *United States v. Mendenhall*, 446 U.S. 544, 551 n.5 (1980); *Youakim v. Miller*, 425 U.S. 231, 234 (1976); *Adikes v. S.H. Kress & Co.*, 398 U.S. 144, 147 n.2 (1970). Indeed, this salutary rule carries particular force in patent cases decided by the Court of Appeals for the Federal Circuit. That court was, of course, chartered "as an exclusive appellate court for patent cases," *Markman v. Westview Instr., Inc.*, 517 U.S. 370, 390 (1996), and one of the principal reasons for concentrating patent appeals in a single court was to "provid[e] a new forum for the *definitive adjudication* of selected categories of cases," including, of course, patent cases. S. Rep. No. 275, 97th Cong., 1st Sess. 3 (1981) (emphasis added). If there were any merit to petitioner's claim that a patent application need not include a written description disclosing the intervenor's possession of the invention (which there is not), the Board and ultimately the Federal Circuit should have been given the first opportunity to address the question, in light of that court's exclusive appellate jurisdiction over, and proven expertise in, issues of patent law.

It would be strange indeed—and certainly not a useful allocation of this Court's scarce resources—to have this Court decide, as a matter of first impression in this case, the question presented by petitioner. Indeed, where—as here—the factual record developed in the agency is complicated and voluminous but highly relevant to the legal issues, it is all the more critical to have those legal issues ventilated and developed in the lower courts. The task of assessing factual agency records lies in the courts of ap-

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on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure." *In re Wertheim*, 541 F.2d at 262.

peals in all but the rarest of instances. *See, e.g., Mobil Oil Corp. v. FPC,* 417 U.S. 283, 310 (1974); *Universal Camera Corp. v. NLRB,* 340 U.S. 474, 491 (1951).

II. THE DECISION BELOW CONFLICTS WITH NO OTHER CIRCUIT OR SUPREME COURT AUTHORITY AND WAS CORRECT

A. No Conflict In Authority Has Been Shown Or Even Alleged

As with most cases that come to this Court from the Federal Circuit, there is no conflict in authority alleged, nor could there be. Rather, petitioner's basis for invoking this Court's certiorari jurisdiction rests entirely upon the supposed "importance" (Pet. 13) of the issue presented. Notwithstanding petitioners' substantial efforts to claim that the issue presented is critical to the continuing health of the patent system, there is in fact no reason to believe that this is the case. *First,* this allegedly important issue was not sufficiently important for petitioner to have raised it in his appellate briefs or on rehearing. *See* Section I, *supra. Second,* not a single judge of the Federal Circuit viewed this case, or the issues actually decided by the Federal Circuit in this case, as sufficiently important to merit rehearing or rehearing *in banc. See* Pet. App. 20a-21a. By sharp contrast, in the handful of patent cases that this Court *has* recently accepted on review from the Federal Circuit, the Federal Cicuit has itself recognized the importance of the case either by accepting the case and deciding it *in banc,* or by addressing a conflict, not present here, between its prior decisions and settled pre-Federal Circuit precedent.[8] *See also* Section III, *infra.*

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[8] *See Lehman v. Zurko,* 119 S. Ct. 401 (1998) (granting certiorari to review Federal Circuit's *in banc* determination of the proper standard of appellate review for factual findings made by the PTO); *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.,* 117 S. Ct. 1040 (1997) (reviewing Federal Circuit's *in banc* determination of the continued validity and contours of the judicially created

B. The Decision Below Was Correct

The Federal Circuit, and before its creation, the Court of Customs and Patent Appeals have consistently applied separate "written description" and "enablement" requirements for complying with Section 112, ¶ 1. *See, e.g., Alton,* 76 F.3d at 1172 (noting that "[t]he adequate written description requirement . . . is distinct from the enablement and best mode requirements"); *Vas-Cath,* 935 F.2d at 1560-64 (analyzing the textual basis for, history and purpose of the separate written description requirement).[9] The written description requirement is grounded in the language of Section 112, ¶ 1 that there be a "written description *of the invention.*" *See, e.g., Alton,* 76 F.3d at 1172; *Vas-Cath,* 935 F.2d at 1560; *In re Ruschig,* 379

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doctrine of equivalents); *Markman,* 517 U.S. at 370 (reviewing Federal Circuit's *in banc* determination of whether patent claim construction is an issue of law subject to judicial resolution, or an issue of fact for jury evaluation); *Pfaff v. Wells Electronics, Inc.,* 119 S. Ct. 304, 308 (1998) (reviewing Federal Circuit's "totality of the circumstances" test for evaluating applicability of the "on-sale bar," 35 U.S.C. § 102(b), primarily "[b]ecause other courts have held or assumed that an invention cannot be 'on sale' within the meaning of § 102(b) unless and until it has been reduced to practice" (citing two pre-Federal Circuit cases from regional circuits—*Timely Products Corp. v. Arron,* 523 F.2d 288, 299-302 (2d Cir. 1975), and *Dart Industries, Inc. v. E.I. du Pont de Nemours & Co.,* 489 F.2d 1359, 1365 n.11 (7th Cir. 1973), *cert. denied,* 417 U.S. 933 (1974)).

[9] *See also In re Wilder,* 736 F.2d 1516, 1520 (Fed. Cir. 1984) (explaining that "[t]he description requirement is found in 35 U.S.C. § 112 and is separate from the enablement requirement of that provision"), *cert. denied,* 469 U.S. 1209 (1985); *In re Smith,* 481 F.2d 910, 914 (CCPA 1973) (stating that "[t]his court has repeatedly recognized a separate description requirement in the first paragraph of § 112"); *In re DiLeone,* 436 F.2d 1404, 1405 (CCPA 1971) (noting that "it is possible for a specification to enable the practice of an invention as broadly as it is claimed, and still not describe that invention"); *In re Ruschig,* 379 F.2d 990, 995-96 (CCPA 1967) (distinguishing enablement from a "written description *of the invention*").

F.2d 990, 995-96 (CCPA 1967). The purpose of this requirement is "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." *Alton*, 76 F.2d at 1172 (quotation omitted). " 'Satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that the prima facie date of invention can fairly be held to be the filing date of the application.' " *Vas-Cath*, 935 F.2d at 1562 (quoting *In re Smith*, 481 F.2d 910, 914 (CCPA 1973)). Petitioner makes a number of unavailing attacks upon this distinct "written description" requirement.

1. A major theme of petitioner's critique of the "written description" requirement is that it is unnecessary because the enablement requirement, standing alone, ought to suffice to insure that the inventor had adequately described and demonstrated possession of his invention. *See, e.g.*, Pet. 17-18. Petitioner, however, misconstrues one of the most important reasons for the written-description requirement—the need to show that an invention (*i.e.*, something distinct from the prior art) is disclosed in the application—that would not be accomplished by an enablement requirement standing alone. As petitioner recognizes (Pet. 17 & n.13) a patent specification is comprised primarily of the written description (including any drawings) and the claims. Petitioner, though, mistakenly advocates, *id.*, that the function of distinguishing an invention from the prior art is completely fulfilled by "the language of the claims." This assertion is simply wrong, and importantly so. "[I]t is not the normal function of a claim to disclose the invention, but to point out the features of novelty in the invention *as disclosed in the specification and drawing of the application.*" *Bocciarelli v. Huffman*, 232 F.2d 647, 651 (CCPA 1956) (emphasis added). If (as petitioner advocates here) a patent application is to serve as proof

of prior invention, then the patent application as filed, not claims added years later, must provide a written description of something that differs from, and represents an advance over, the prior art. "When the scope of a claim has been changed by amendment in such a way as to justify an assertion that it is directed to a *different invention* than was the original claim, it is proper to inquire whether the newly claimed subject matter was *described* in the patent application when filed as the *invention* of the applicant." *In re Wright*, 866 F.2d 422, 424 (Fed. Cir. 1989) (emphasis added).

Indeed, historically, a major function of the written-description requirement has been to "distinguish [the invention] *from all other things before known.*" Patent Act of 1793, § 3, 1 Stat. 318; *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356, 434 (1822); that function continues under the present Patent Act. *See, e.g., Wright*, 866 F.2d at 424 (under the "written description" requirement, "[t]he specification as originally filed must convey clearly to those skilled in the art the information that the applicant has *invented* the specific subject matter later claimed.") (quotation omitted, emphasis added). Enablement, by contrast, can be demonstrated without showing anything different from the prior art. A patent may be enabling without disclosing "what is well known in the art." *E.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987). To be enabling for purposes of 35 U.S.C. § 112, ¶ 1, a patent can merely rely on information "well known in the art" that allows others to "make and use" the invention. Indeed, that is what Hyatt seeks to do here, admitting that he lacked the knowledge to build a single-chip computer himself, intending instead to rely on the knowledge of a "company that built custom integrated circuits." Pet. App. 36a. Without a separate requirement that Hyatt's 1970 application describe his later-claimed "invention" with sufficient clarity to show that he possessed an idea dif-

ferent from what came before, Hyatt would be conferred 1970 priority based on a patent application that disclosed nothing new.[10]

2. Petitioner also suggests (Pet. 16) that the text of 35 U.S.C. § 112, ¶ 1 does not support separate "written description" and "enablement" requirements. But Section 112, ¶ 1 specifically requires written description both "of the invention *and* of the manner and process of making and using it." (Emphasis added.) Furthermore, it is only the latter description requirement—"of the manner and process of *making and using* it" that must satisfy the additional prerequisite that it be "in such full, clear, concise, and exact terms as to *enable* [a skilled artisan] to *make and use* the same." Under petitioner's contrary interpretation, the paragraph would read:

> The specification shall contain a written description of the invention . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same . . . .

But such a reading would "render superfluous the requirement that the specification contain a written description—'of the manner and process of making and using it [the invention],'" for "if there were a description enabling

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[10] Petitioner seeks to make much of the fact that the Federal Circuit has used the phrase "possession of the invention" to refer to what was invented, and urges that the language of "possession" does not encompass distinction of the prior art. Pet. 17. However, the concept of "possession" of the invention has always encompassed such a distinction. As this Court held in *Evans*, the language of the 1793 Patent Act, mandating that the "written description" "distinguish [the invention] from all other things before known," was meant "to put the public *in possession of* what the party claims as *his own invention*, so as to ascertain if he claims anything that is in common use or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented" 20 U.S. at 434 (quoted in *Vas-Cath*, 935 F.2d at 1561) (emphasis added).

'any person skilled in the art . . . to make and use,' there would be no need to require a description of the 'manner and process of making and using.'" *In re Barker*, 559 F.2d 588, 591 (CCPA 1977), *cert. denied*, 434 U.S. 1064 (1978). Thus, petitioner's reading is contrary to the well-settled principle of statutory construction that "it is presumed that Congress did not use superfluous words." *Id.* at 592 (citing *United States v. Menasche*, 348 U.S. 528, 538-39 (1955)).[11]

3. At most turns, petitioner also attempts to shoehorn his case into the reasoning of this Court's recent decision in *Pfaff v. Wells Electronics, Inc.*, 119 S. Ct. 304 (1998). Pet. 2, 12-13, 17-18, 25-26. Petitioner's efforts to force-fit his newly raised question presented into the rubric of *Pfaff* is unavailing. This Court held in *Pfaff* that the "on-sale bar"—contained in a different section of the Patent Act, 35 U.S.C. § 102(b)—applies to an invention that is both the subject of a commercial offer for sale and "ready for patenting." This Court in *Pfaff* explained that this latter, ready-for-patenting condition "*may* be satisfied" by "proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention," even if not disclosed in the patent application, "that were sufficiently specific to enable a person skilled in the art to practice the invention." *Id.* at 311-12.

Plaff is inapposite for at least two fundamental reasons. *First*, contrary to petitioner's intimation (Pet. 2), the written-description requirement has nothing to do with whether an invention is "ready for patenting" in the physical sense. Rather, the written-description requirement addresses whether an invention, admittedly "ready for patenting,"

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[11] The "written description" requirement's textual basis and long history of consistent application also make it very different from the "reduction-to-practice" and "substantial completion" standards rejected in *Pfaff*. Those rejected standards had no textual bases and were inconsistently applied by the courts of appeals.

was sufficiently described in a prior patent application so that the public would know how the invention is different from (and advances) the prior art. The "on-sale bar" rule at issue in *Pfaff* does not concern itself with distinctions over prior art, or disclosing those distinctions to the public, but concerns primarily whether the inventor is permitted to exploit his invention before patenting. *See* 119 S. Ct. at 310.[12] *Second,* whether or not the "ready for patenting standard" is synonymous with the "enablement" requirement—and the Court's use of the permissive standard of "may be satisfied" by enabling drawings or descriptions suggests that it is not—the purpose of requiring a written description of an "invention" advancing the prior art, absent from both the enablement requirement and the "ready for patenting" standard, renders *Pfaff* wholly inapplicable to the written-description requirement of 35 U.S.C. § 112, ¶ 1.

4. Finally, petitioner argues (Pet. 22-25) that the written-description requirement discriminates against amended claims in contravention of Congress's wishes. This contention is without merit for three reasons. *First,* while inventors are permitted to amend their claims, where that amendment process converts the original matter into a "*different invention,*" it is both logical and "proper" to determine whether the "newly claimed subject matter was *described*" in the original application. *Wright,* 866 F.2d at 424. *Second,* the concept that an amended claim must be so described predates substantially the drafting of Section 112 and must have been known by its draftsmen. "[T]he law is well settled that one who extracts claims from an issued patent must show clear prior disclosure." *Brand v. Thomas,* 96 F.2d 301, 303 (CCPA 1938). *Third,*

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[12] Indeed, the information that demonstrates an invention is "ready for patenting" under *Pfaff* would not, by definition, be contained in any patent application. In contrast, the information relevant for the written-description requirement must be contained within the specification of a patent application. 35 U.S.C. § 112, ¶ 1.

contrary to petitioners' suggestion, since Section 120 was amended in 1984, *see* 35 U.S.C.A. § 120, Historical Notes (West Supp. 1998), and Section 112 was amended in 1975, *see* 35 U.S.C.A. § 112, Historical Notes (West 1984), both well after the consistent application of the written-description requirement—even according to petitioner's faulty timetable—this Court's presumption is that Congress approved of the Federal Circuit's prevailing interpretations of those sections. *See, e.g., Lindahl v. OPM*, 470 U.S. 768, 782-83 & n.15 (1985) ("Congress is presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it reenacts a statute without change") (citing *Albemarle Paper Co. v. Moody*, 422 U.S. 405, 414 n.8 (1975)).

In sum, the Federal Circuit's reading of 35 U.S.C. § 112, ¶ 1 as containing separate written-description requirements for both the "invention" and "the enablement thereof" is entirely correct and does not merit this Court's review.

III. THIS CASE PRESENTS NO ISSUE WORTHY OF THIS COURT'S CONSIDERATION

For several reasons, this case presents no issue worthy of this Court's consideration.

First. As do most interference proceedings, this case involved substantial, dispositive factual findings by the Board, which were in turn bottomed upon a voluminous record (nearly 27,000 pages) of patent applications, prosecution histories, documentary evidence and testimony. Under the well-settled precedent of both the Court of Appeals for the Federal Circuit and its predecessor, the CCPA,[13] Board decisions applying the § 112, ¶ 1 standards are reviewed under the deferential "clearly erroneous" standard. Pet. App. 5a (citing *Vas-Cath*, 935 F.2d at

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[13] Pet. App. 7a-8a; *see also, e.g., Lockwood v. American Airlines, Inc.*, 107 F.3d at 1571-72; *Martin v. Mayer*, 823 F.2d at 505.

1563).[14] As a consequence of this deferential review, and in recognition that each interference turns on its precise facts, the Federal Circuit has noted that " 'the precedential value of cases in this area is extremely limited.' " *Vas-Cath*, 935 F.2d at 1562 (quoting *In re Driscoll*, 562 F.2d 1245, 1250 (CCPA 1977)); *see also Wertheim*, 541 F.2d at 262 ("[t]he primary consideration is *factual*").[15] So too, any decision that this Court could possibly render would have very limited precedential significance. In such circumstances, this Court has expressed reluctance to grant review. *See, e.g., First Options of Chicago, Inc. v. Kaplan*, 514 U.S. 938, 949 (1995) (emphasizing that a "fact-bound issue" was beyond the scope of questions Court agreed to review); *Smith v. Allwright*, 321 U.S. 649, 669 (1944) (Roberts, J., dissenting) (the Court should not review cases that are in "the same class as a restricted railroad ticket, good for this day and train only").

Second. Despite petitioner's efforts to show that "[t]he issues in this case are of substantial importance to the proper administration of the Patent Act" (Pet. 25; *see generally* Pet. 25-27), the supposed "obstacles," "repercussions" and "burdens" (Pet. 26) that are said to follow from the decision below are at best speculative and hypothetical ones. As noted above at p. 16, neither petitioner

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[14] Indeed, the pending case of *Lehman v. Zurko*, 119 S. Ct. 401 (granting certiorari) presents the question of whether Board findings should be reviewed under an even more deferential standard than "clear error" (such as "arbitrary and capricious" or "substantial evidence"). A departure from the present "clearly erroneous" review in that case would only serve to make the present case even less worthy of certiorari than it already is.

[15] And, indeed, in this case, the Board's findings—for example, its finding that the 1970 application's distinct use of the terms "program" and "program means" elsewhere in its specification "*makes it clear that the 'program means' is not a processing circuit*," and thus that claim 40 of that application does not disclose a single chip computer, Pet. App. 33a-34a—are not challenged as clearly erroneous and thus demonstrate that the Federal Circuit's decision is correct, regardless of the legal standard applied.

nor any judge of the Federal Circuit thought that this issue was sufficiently important to merit presentation to or consideration by the *in banc* Federal Circuit. Additionally, because the question presented here was not briefed or argued below, there was no evidence presented below, or presented in the petition (aside from lawyer argument) that the Federal Circuit's rule—which has been the prevailing rule, without departure, for at least thirty-five years[16] and probably longer—has caused any problems for patent applicants, the PTO, or any others with an interest in the patent system. Even were there such problems, the Court should at the very least await a case in which such showings can be developed in the record and addressed by the Federal Circuit.

Third. In all events, review of the present case would be complicated by the alternative collateral estoppel ground for affirmance of the Board's decision, which divided the Board, Pet. App. 40a-44a (Urynowicz, J.); *id.* at 45a (Pate, J.); *id.* at 45a-50a (Lee, J.), but was not reached by the Federal Circuit in view of its holding on the merits of the enablement issue. In its 1988 decision in *In re Hyatt*, No. 87-1597 (Fed. Cir. June 9, 1988) (A1252-62), the Federal Circuit ruled that Hyatt's 1970 application—the same one involved here—did not enable patent claims that were virtually identical to those at issue here. As the Federal Circuit held in *Amgen Inc. v. Genetics Institute, Inc.*, 98 F.3d 1328, 1332 (Fed. Cir. 1996), in cases where "the same issue of enablement arises as was decided in [a prior proceeding]," relitigation is prohibited by the doctrine of issue preclusion, even though the patent claims in the two proceedings may have minor differences. In view of these rulings, petitioner would not be able to show that his 1970 application was enabling and, regardless of the outcome of his challenge to the no-written-description holding of the Federal Circuit, the Board's denial of benefit would have to be affirmed on the alternative ground of

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[16] *See Jepson v. Coleman*, 314 F.2d at 536.

non-enablement. Even were all of the other requisites for certiorari present—which they are not—the Court should certainly prefer a vehicle for resolution of this issue that is not complicated by issues of preclusion.

CONCLUSION

For the foregoing reasons, the petition should be denied.

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December 1998

APPENDIX

APPENDIX

[Filed July 15, 1998]

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Appeal Nos. 95-1514, -1515

GILBERT P. HYATT,
Appellant,

-v.-

GARY W. BOONE,
Cross-Appellant.

Appeal from a Decision of the
Board of Patent Appeals and Interferences
dated September 19, 1995 and May 10, 1996

GILBERT P. HYATT'S PETITION FOR
REHEARING AND SUGGESTION FOR
REHEARING IN BANC

* * * *

INTRODUCTION

This is an appeal from a decision of the United States Patent and Trademark Office, Board of Patent Appeals and Interferences (the "Board"). The appeal involves a patent interference between (1) U.S. Patent No. 4,942,516, entitled "Single Chip Integrated Circuit Com-

puter Architecture," issued to Gilbert P. Hyatt ("Hyatt") and claiming priority to original patent application Serial No. 101,881 (the "'881 application") and (2) patent application Serial No. 473,541, entitled "Variable Function Programmed Systems" by Gary W. Boone ("Boone"). The primary issue on appeal is whether the '881 application provides a written description of a computer having two memories and a processing circuit implemented on a single integrated circuit chip as defined by the sole Count-in-interference (the "Count").

POINTS OF FACT AND LAW OVERLOOKED OR MISAPPREHENDED BY THE PANEL

As detailed in Hyatt's opening and reply briefs, it is *undisputed* that the body of the '881 application expressly describes an electronic data processing system—a computer—having two memories and a processing circuit that operate as required by the Court. It is also *undisputed* that the body of the application describes the data processing system implemented as a completely integrated circuit or "monolithic" computer, and that a monolithic computer is a computer implemented on one or more chips. It is thus *undisputed* that the body of the '881 application expressly describes all the limitations of the Count except for the specific words "single integrated circuit chip." However, it is also *undisputed* that original Claim 40 of the '881 application expressly describes an "electronic data processing system . . . implemented on a single integrated circuit chip." Since an original claim is to be read on what is disclosed in the application and not as a different embodiment, *Bocciarelli v. Huffman*, 232 F.2d 647, 651, 109 USPQ 385, 388 (C.C.P.A. 1956), the description of a monolithic computer in the body of the application must be read together with original Claim 40. Together they provide a complete, express description of the Count.

Simply put, the body of the '881 application expressly describes the computer defined by the Count and original

Claim 40 complements that description by expressly describing implementation of *the disclosed computer* on a single integrated circuit chip. As a result, the '881 application provides a complete written description of the Count—it "reasonably conveys" to those skilled in the art that Hyatt was in possession of the invention defined by the Count.

In deciding this appeal, the Panel ignored the body of the '881 application on the mistaken belief that it did not describe or suggest a single chip computer. It then decided that original Claim 40 *alone* did not "necessarily" provide a written description of the Count. The Panel failed to consider claim 40 in conjunction with the monolithic computer—a computer implemented on one or more chips—even though it is undisputed that claim 40 reads on the previously described monolithic computer and expressly describes implementation on a single chip. The Panel looked only at original Claim 40, despite the requirement to consider the application "as a whole." *See, e.g., In re Wright*, 866 F.2d 422, 425, 9 USPQ 2d 1649, 1651 (Fed. Cir. 1989) (application must be considered "as a whole" to decide compliance with 35 U.S.C. § 112, ¶ 1).

Accordingly, Hyatt submits this petition for rehearing because the Panel overlooked or misapprehended the express teaching in the body of the '881 application of a completely integrated circuit or monolithic computer.

ISSUE OF LAW NECESSITATING CONSIDERATION OF THE FULL COURT TO MAINTAIN UNIFORMITY OF ITS DECISIONS

Prior precedent of this Court has held that the proper test for determining compliance with the written description requirement of 35 U.S.C. § 112 ¶ 1 when dealing with an express diclosure is whether an application "reasonably conveys" possession of the invention. *See, e.g., Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1115-16 (Fed. Cir. 1991). Prior prece-

dent has also developed a stricter "necessary and only" test for meeting the written description requirement when an inventor needs to rely on an *inherent* feature not expressly described within his application. *See, e.g., Kennecott Corp. v. Kyocera Int'l Inc.*, 835 F.2d 1419, 1423, 5 USPQ2d 1194, 1198 (Fed. Cir. 1987), *cert. denied*, 486 U.S. 1008 (1988) (hereinafter "*Kennecott*"). *See also In re Daniels*, No. 97-1225, 1998 WL 257309 at *2, 46 USPQ2d 1788 (Fed. Cir. May 20, 1998) (necessary test used when a disclosure is "less than clear on its face . . .")

The Panel in the present case recognized that this Court's precedent has used the two phrases "reasonably conveys" and "necessary and only" in deciding written description issues. (Decision, p. 9.) However, the Panel held that those two distinct phrases were not "divergent standards for compliance with § 112." (Decision, p. 9-10.) As a result, the Panel established a new precedent—it merged the standard for express disclosure into the standard for inherent disclosure and phrased the merged standard as a "necessarily comprehended" test for written description. (Decision, p. 10.) The Panel then applied its "necessarily comprehended" test to decide that the '881 application did not provide a written description of the Count. (Decision, p. 10.)

The Panel's "necessarily comprehended" test applied to an express written description is in direct conflict with prior precedent of this Court. Moreover, by applying its overly-strict "necessarily comprehended" test, the Panel reached the wrong result—finding that the '881 application did not provide a written description of the Count. Accordingly, Hyatt suggests that the present appeal be reheard in banc to allow this Court to maintain uniformity with its prior decisions concerning the written description requirement of 35 U.S.C. § 112, ¶ 1.

ARGUMENT

A. The Panel Overlooked or Misapprehended the Fact That the Body of the '881 Application Describes A Completely Integrated Circuit or Monolithic Computer

When a panel overlooks or misapprehends an essential fact or rule of law, rehearing of the appeal is appropriate, Fed. Cir. R. 40; *See, e.g., Frederick v. Department of Justice*, No. 95-3194, 1996 WL 293120, *1 (Fed. Cir. May 22, 1996). That has happened here.

Central to the Panel's decision that the '881 application did not provide a written description of the Count was its erroneous findings (i) that other than original Claim 40, there is no description or suggestion in the body of the application of a computer implemented on a single integrated circuit chip and (ii) that the Board made a similar finding. As stated by the Panel:

> *There is no other mention in the '881 application of a single integrated circuit chip*, although other electronic data processing systems are extensively described.
>
> * * *
>
> *The Board found* that the parts of the written description that are lacking from Claim 40 are not provided elsewere in the '881 specification, whose systems and circuitry neither describe nor suggest a computer on a single chip.

Decision, pp. 6-7 (Emphasis added).

The Panel then looked only at original Claim 40 without reference to the body of the application and decided that Claim 40 *alone* did not describe the two memories and the single chip processing circuit of the Count.

The Panel made a fundamental and material error. The body of the '881 application *does* describe a com-

pletely integrated circuit or monolithic computer. Moreover, the Board *never* made a contrary finding.

The body of the '881 application expressly describes in detail a computer having two memories and a processing circuit that operate as recited in the Count. As clearly shown in Figs. 1 and 4 (A326), it is undisputed that the application discloses an electronic data processing system having (1) a main memory 30 for storing computer instructions (the "main memory" of the Count), (ii) an alterable scratch pad memory 110 which stores operands (the "operand memory" of the Count), and (iii) a data processor 12 which processes operands stored in the alterable scratch pad memory 110 in response to instructions stored in the main memory 30 (the "processing circuit" of the Count). For a more detailed discussion of these features see Hyatt's Main Brief, pp. 10-17.

The application also teaches that the basic design or "architecture," of its processing circuit 12 permitted the system to use an integrated circuit read only memory to create a "completely integrated circuit computer," expressly described as a "monolithic computer." (A210, lines 13-19.) The term "monolithic computer" was understood in the art as an express description or suggestion of a computer capable of being implemented on a single integrated circuit chip. (A493-95, A431-32, A1011-12.) In fact, Boone's own expert witness, Dr. Wooley, testified that the term "monolithic" described a single integrated circuit chip, or a combination of integrated circuits, i.e. one or more chips. (A 3103.) Further, Boone himself used the term "monolithic calculator" to describe his single chip calculator in the corresponding Boone application-in-interference. (*See, e.g.*, A2534, line 12.) See Hyatt's Reply Brief, pp. 6-7, for further discussion of the term monolithic.

The Panel's error in not considering the application's disclosure "as a whole", including the description of a

monolithic computer and not reading Claim 40 in conjunction with that disclosure was not harmless. *In re Wright*, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989).

It is black letter law that an original claim to an application is part of the original disclosure. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 938, 15 USPQ2d 1321, 1326 (Fed. Cir.), *cert. denied*, 498 U.S. 920 (1990); *In re Edwards*, 568 F.2d 1349, 1352, 196 USPQ 465, 468 (C.C.P.A. 1978). However, to determine what an original claim decribes for § 112 purposes, one must look at what the original claim discloses in the context of the body of the application rather than as a different embodiment. *Bocciarelli v. Huffman*, 232 F.2d 647, 651, 109 USPQ 385, 388 (C.C.P.A. 1956). Accordingly,

> if an original claim can be given a reasonable interpretation which will make it readable on what is disclosed in the specification or drawing, it is proper to adopt that interpretation rather than to seek to construe broad language in the claim as a disclosure of other embodiments.

Id. at 651, 109 USPQ at 388.

The rationale for that rule is clear. Original claims to an application are designed to broadly point out the novel features *of the invention disclosed in the original application*. In this case, Claim 40 is fully compatible with the monolithic computer disclosed in the body of the '881 application. The read only memory means of Claim 40 corresponds to the integrated circuit read only memory 30 of the monolithic computer while the alterable memory means of Claim 40 corresponds to the alterable operand memory 110 of the monolithic computer. Regardless of whether the program means of Claim 40 is interpreted to mean a program or a data processing circuit, it is consistent with the previous description of a monolithic com-

puter, which has both. Further, since Boone's own witness testified that monolithic is defined as implementation on one or more chips (A3103), the Claim 40 recitation of a single chip is also fully compatible with the monolithic computer.

It is thus clear that there are no differences that can support a conclusion that Hyatt's monolithic computer and Claim 40 represent different embodiments. *See also* Hyatt's Main Brief pp. 17-18 and Hyatt's Reply Brief pp. 5-13. Boone has not, and indeed cannot, point to a single element of Claim 40 that is incompatible with Hyatt's previously disclosed monolithic computer that is to be implemented on one or more chips. Since Claim 40 is fully consistent with the monolithic computer, the descriptions of the monolithic computer and of Claim 40 must be read together as the description of a single embodiment.

Contrary to the decision (p.6), Hyatt does *not* contend that Claim 40 by itself describes the subject matter of the inference count. Hyatt does contend, and it is *undisputed,* that the body or the application expressly describes a monolithic computer having every feature of the count implemented on one or more chips. When this undisputed description is combined with the single chip recitation of Claim 40, which reads on Hyatt's monolithic computer, the '881 application provides an express written description of every feature of the Count.

In re Ruschig, 379 F.2d 990, 154 USPQ 118 (C.C.P.A. 1967), is the first case clearly recognizing the written description requirement. 4 Chisum § 7.04[1][a][1] (1998). The court there stated:

> It is an old custom in the woods to mark trails by making blaze marks on the trees. It is no help in finding a trail or in finding one's way through the woods where the trails have disappeared—or have not yet been made. . .—to be confronted simply by

> a large number of unmarked trees. Appellants are pointing to trees. We are looking for blaze marks which single out particular trees.

In re Rushig, 379 F.2d at 994-95, 154 USPQ at 122. The detailed teaching of a completely integrated circuit or monolithic computer in the body of the '881 application, in combination with Claim 40, provides just such blaze marks to the subject matter of the Count.

B. This Appeal Should Be Heard In Banc To Maintain Uniformity With Prior Precedent On The Proper Test for the Written Description Requirement Under 35 U.S.C. § 112, ¶ 1

A rehearing in banc will be ordered when a Panel's decision is contrary to prior precedent and, as a result, consideration of the full Court is necessary to secure or maintain uniformity of its decisions or overrule its prior decisions. Fed. Cir. R. 35; *see also Cybor Corp. v. FAS Technologies, Inc.* 138 F.3d 1448, 1455-56, 46 USPQ2d 1169, 1173 (Fed. Cir. 1998) (in banc review required in order for this Court to maintain uniformity of its decisions concerning the proper standard of review for claim construction issues); *Nobelpharma AB v. Implant Innovations, Inc,,* 141 F.3d 1059, 1068 n.5, 46 USPQ2d 1097, 1104 n.5 (Fed. Cir. 1998) (in banc review required to overrule this Court's prior decisions concerning antitrust issues). Since the Panel's decison concerning the written description requirement is contrary to this Court's precedent, a rehearing in banc is warranted.

As detailed in Hyatt's opening and reply briefs, when an application expressly discloses the invention the proper test for determining compliance with the written description requirement of 35 U.S.C. § 112 is whether that disclosure "reasonably conveys" to one skilled in the art that the inventor was in possession of the later claimed invention. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1115-16 (Fed. Cir. 1991). The

"reasonably conveys" test has been consistently applied by this Court in deciding the issue of express written description under § 112.[1] Moreover, it has been adopted by the PTO as the proper test for review of patent applications.[2]

However, unlike the present case, when an application does not expressly describe a claim limitation but discloses a device that "inherently" has a property meeting that limitation, the inventor can rely on that inherent property to satisfy the written description requirement. *In re Reynolds*, 443 F.2d 384, 389, 170 USPQ 94, 98 (C.C.P.A. 1971). To prove the inherent property, the inventor has to meet a stricter "necessary and only" test—the inventor must show that the " 'necessary and only reasonable construction to be given the disclosure by one skilled in the art is one which will lend clear support to . . . [this] positive limitation.' " *Kennecott*, 835 F.2d at 1423, 5 USPQ2d at 1198 (quoting *Langer v. Kaufman*, 465 F.2d 915, 918, 175 USPQ 172, 174 (C.C.P.A. 1972)). The same "necessary and only" test for an inherent disclosure is also used when determining whether a prior art reference under 35 U.S.C. § 102 inherently discloses a claimed feature.[3]

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[1] *See, e.g., Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Hayes Microcomputer Prods., Inc.*, 982 F.2d 1527, 1533, 25 USPQ2d 1241, 1245 (Fed. Cir. 1992); *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (hereinafter *"Ralston Purina"*).

[2] Manual of Patent Examining Procedure § 2163 (1996); *Request for Comments on Interim Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112 ¶ 1* (hereinafter *"Interim Guidelines"*); *"Written Description" Requirement*, 63 Fed. Reg. 32,639-45 (1998).

[3] *See, e.g., Electro Medical Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1020 (Fed. Cir. 1994) (Court applied necessary test to determine if prior art inherently anticipated claimed invention); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (same).

Very recently, this Court touched on this issue when it reiterated that the "reasonably conveys" test is used to determine compliance with the written description requirement, citing *Ralston Purina,* and the "necessary" test is used when a disclosure is "less than clear on its face," citing *Kennecott,* an inherency case. *In re Daniels,* No. 97-1225, 1998 WL 257309, at *2 (Fed. Cir. May 20, 1998).

In view of the distinct standards, this Court has held that when an application expressly describes a limitation, as in the present case, it is reversible error to apply the "necessary and only" test. Specifically, if the limitation is expressly described, it is improper to require the application to "necessarily exclude" other limitations or "necessarily include" a limitation that excludes all other possible limitations. *Vas-Cath,* 935 F.2d at 1566-67, 19 USPQ2d at 1119 (district court committed reversible error by requiring under § 112 that the original application *necessarily exclude* other limitations not claimed after expressly describing the claimed limitation).

The Panel in the present case recognized that prior precedent of this Court has used the two phrases "reasonably conveys" and "necessary and only" in deciding written description issues. (Decision, p. 9.) However, the Panel held that those two distinct phrases were not "divergent standards for compliance with § 112." (Decision, pp. 9-10.) As a result, the Panel established new precedent—it merged the standard for explicit disclosure into the standard for inherent disclosure using the phrase "necessarily comprehended." (Decision, p. 10.) The Panel then applied its strict "necessarily comprehended" test to an explict disclosure to decide that original Claim 40, standing alone and apart from its supporting disclosure, did not provide a written description of the Count. (Decision, p. 10.)

The Panel's decision is in direct conflict with the prior precedent of this Court which established the "reasonably

conveys" test as the proper test for express written description. The Panel's decision is also in conflict with the recently published *In re Daniels* decision which recognized that a distinction in the law exists.

If left standing, the Panel's decision will wrongfully deny Hyatt priority to his original application. As detailed above, there is no dispute that (1) the '881 application describes a monolithic computer having two memories and a processing circuit that operated as recited in the Count and (2) original Claim 40 describes implementing a computer on a single integrated circuit chip. Since the three elements recited in Claim 40 are all found in the monolithic computer, one skilled in the art would recognize that the computer described in original Claim 40 is the same monolithic computer that is described throughout the body of the application. To require that original Claim 40 necessarily exclude all other computers is an improper standard for complying with the written description requirement. *Vas-Cath Inc.*, 935 F.2d at 1566-67, 19 USPQ2d at 1119.

Moreover, the Panel's decision will wreak havoc in the PTO—where numerous applications are reviewed daily for compliance with the written description requirement—and in the courts whenever the written description requirement is at issue.

As applied, the Panel's "necessarily comprehended" test would require inventors to not only describe their inventions but also to expressly describe what their inventions necessarily *exclude*. That is, to expressly describe all embodiments which the inventor does *not* consider to be his invention, as was the effect of the decision in this case.

The Panel's decision also adds to the confusion in this Circuit concerning the written description requirement rather than clarifying it. For example, as discussed above, in *In re Daniels* this Court defined a second "necessary"

test that is to be applied when a disclosure is "less than clear on its face" and then cited an inherency case, *Kennecott*, as authority. In another example, *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1480, 45 USPQ2d 1498, 1503-04 (Fed. Cir. 1998), this Court decided that a disclosure of a preferred embodiment was insufficient under the written description requirement to support a claim broader than that which was expressly disclosed—a decision sharply criticized by the patent bar. *See, e.g.*, Laurence H. Pretty, *Federal Circuit Narrows the Protection of Patents Closer Toward Their Specific Disclosures*, IPL Newsletter, Vol. 16, No. 3, Spring 1998.

Finally, the PTO recently published *Interim Guidelines* setting forth its understanding of the law concerning the written description requirement under 35 USC §112, ¶ 1 and requesting comments.

In view of the Panel's improper, and case dispositive, restatement of the test for written description, recent decisions of this Court obfuscating the law on written description, and the PTO's recent request for comment, Hyatt suggests that this appeal be heard in banc to allow this Court the opportunity to maintain uniformity with its prior decisions and to clarify the law concerning the written description requirement under 35 U.S.C. § 112, ¶ 1.

CONCLUSION

For the reasons stated above, the Panel should rehear this case. If the Panel decides not to rehear this case, the Court should set this case for in banc briefing and argument.

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IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Appeal Nos. 96-1514, -1515

GILBERT P. HYATT,
Appellant,

v.

GARY W. BOONE,
Cross-Appellant.

Appeal from a Decision of the
Board of Patent Appeals and Interferences
dated September 19, 1995 and May 10, 1996

BRIEF FOR APPELLANT GILBERT P. HYATT

STATEMENT OF THE ISSUES

POINT I:

Whether the Board committed reversible error in denying Hyatt benefit of the '881 application by deciding that the application failed under 35 U.S.C. § 112 to describe a "computer on a chip" as defined by the Count.

A. Whether the Board committed reversible error by looking *only* at original Claim

40, failing to consider the *whole* '881 application.

B. Whether the Board committed reversible error by improperly applying the "necessary" test for an inherent description instead of the proper "reasonably conveys" test for an express description.

POINT II:

Whether the Board committed reversible error in giving Boone benefit of his 1971 application in view of at least two breaks in his chain of priority applications.

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No. 98-856

IN THE
Supreme Court of the United States
OCTOBER TERM, 1998

GILBERT P. HYATT,
Petitioner,
v.
GARY W. BOONE,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

REPLY BRIEF FOR PETITIONER

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REPLY BRIEF FOR PETITIONER

The petition in this case rested, in large part, on a simple point: that Section 112, ¶ 1 of the Patent Act contains only one written description requirement, not two. In particular, we argued that the second written description requirement created by the court of appeals—that the specification contain a written description showing "possession of the invention"—was an unfounded addition to the traditional requirement of a written description sufficient to enable the making and using of the invention. This second requirement not only finds no warrant in the language of the statute, but is contrary to the basic understanding, recently reaffirmed by this Court (*see Pfaff v. Wells Electronics, Inc.*, 119 S. Ct. 304, 311-12 (1998)), that a description allowing the practice of an invention demonstrates that the inventor has fully conceived of that invention. The possession-of-the-invention requirement thus adds a needless element of confusion and uncertainty

to the patenting process, without serving any interest not already served by proper application of the enablement requirement.

Faced with these arguments, respondent takes several unusual tacks. Most notably, he seeks to defend the second written description requirement on a ground—that it is necessary to show that the invention is an advance over prior art—that has never even been mentioned, much less relied upon, by the Federal Circuit itself. To make matters worse, he then suggests that the written description in a specification must serve this role, instead of the patent *claims*, despite the fact that the relevant statutory history (this purpose for the description was eliminated in 1836) and the uniform weight of authority are to the contrary. The result is utter confusion: what appears on its face to be a straightforward requirement for the written description of an invention, that it enable the making and using of that invention, has now been stretched to encompass a possession-of-the-invention requirement that was never in the statute at all and a distinguish-the invention-from-prior-art requirement that was dropped from the statute more than 160 years ago (as that role was assumed by the patent claims).

The same misconception by respondent guides his erroneous reading of *Pfaff* as well. While it is true that the "on-sale bar" at issue in *Pfaff* "does not concern itself with distinctions over prior art" (Br. in Opp. 22), neither does the written description requirement of Section 112, ¶ 1. What they do concern, however, is the point at which an inventor is deemed to have a complete conception of his invention. This Court stated clearly in *Pfaff* that an invention is "complete and ready for patenting" (119 S. Ct. at 311) at the point that the inventor has prepared a description "sufficiently specific to enable a person skilled in the art to practice the invention." 119 S. Ct. at 312. If that is so, then it follows that an enabling description in a patent specification is enough to show that an inventor has completely conceived of his invention at that time.

An additional "possession-of-the-invention" requirement thus serves only to erect a further arbitrary barrier to the patenting process without any legitimate purpose.

1. Although respondent concedes that the question of the standards to be applied to the possession-of-the-invention requirement is properly before the Court, he argues that the underlying issue of the validity of the requirement itself is not. Br. in Opp. 13-16. But, in pressing this argument, respondent ignores the decisions of this Court clearly holding that it (or other federal courts) may "consider an issue 'antecedent to . . . and ultimately dispositive of' the dispute before it, even an issue the parties fail to identify and brief." *United States National Bank of Oregon v. Independent Ins. Agents of America, Inc.*, 508 U.S. 439, 447 (1993) (quoting *Arcadia v. Ohio Power Co.*, 498 U.S. 73, 77 (1990)). *See Missouri v. Jenkins*, 515 U.S. 70, 84-85 (1995) (addressing "an issue subsidiary to our ultimate inquiry"). Likewise, the Court has considered arguments, even though not previously raised by the parties, where the issues were nevertheless a "predicate to an intelligent resolution" of questions before it. *See Vance v. Terrazas*, 444 U.S. 252, 258-59 n.5 (1980). *See also Ohio v. Robinette*, 117 S. Ct. 417, 420 (1996); *Caterpillar, Inc. v. Lewis*, 117 S. Ct. 467, 476 n.13 (1996). Here, the legitimacy of the possession-of-the-invention requirement is both an issue "antecedent to . . . and ultimately dispositive of" the dispute about the standards to be applied to the requirement and a "predicate to an intelligent resolution" of that dispute.

Respondent further argues that "the Federal Circuit should have been given the first opportunity to address the question . . . ." Br. in Opp. 15. But that argument disregards the obvious fact that the Federal Circuit has squarely addressed the question and made clear its view. Eight years ago, in *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991), the court sought to eliminate "some confusion in our decisions" (*id.* at 1563) by ex-

pressly reaffirming the existence of a second written description requirement. *Id.*[1] The Federal Circuit subsequently has applied that requirement without further circumspection, including in the present case. It would thus be an empty formalism to require litigants before the Federal Circuit to express repeated disagreement with a requirement that the court has recently reconsidered and unequivocally reembraced. It is review by this Court, not further review by the Federal Circuit, that is needed.

2. We argued in the petition that the second written description requirement (showing possession of the invention) serves no legitimate purpose not already served by the traditional written description requirement (enabling the making and using of the invention). As we there indicated, the problem is not with the general notion that an inventor must show possession of his invention; rather, the problem is with the idea that a description sufficient for enablement is nonetheless not sufficient to show possession. By insisting on a requirement "separate and distinct from the enablement requirement," *Vas-Cath*, 935 F.2d at 1563, the Federal Circuit has simply created a standardless, and often arbitrary, impediment for inventors, which serves to deprive them of patents to which (under a proper reading of Section 112, ¶ 1) they are rightfully entitled.

Respondent tries to answer this argument by putting forth his own explanation for a second written description requirement: "the need to show that an invention (*i.e.*, something distinct from the prior art) is disclosed by the application . . . ." Br. in Opp. 18. This theory, however, simply confirms how much confusion can be engendered

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[1] The admission by the Federal Circuit of "confusion in [its] decisions" belies respondent's assertion that the second written description requirement has a "long history of consistent application." Br. in Opp. 21 n.11; *see also* Br. in Opp. 17 ("consistently applied"). For the same reason, there is nothing to the point that Congress implicitly ratified the requirement, during the period of confusion, by amending Sections 120 and 112 of the Act. *See* Br. in Opp. 22-23.

by a second, non-statutory written description requirement. Most obviously, the justification offered by respondent has nothing whatsoever to do with the justification offered by the Federal Circuit: "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." *In re Alton*, 76 F.3d 1168, 1172 (Fed. Cir. 1996) (internal quotes omitted). (In our view, of course, that purpose of the requirement is served by an enabling description without more.) Indeed, the explanation given by respondent seems to have nothing to do with the concept of demonstrating "possession of the invention"—which, after all, assumes that there is an invention—but rather with the concept of identifying an invention to be possessed.

The theory presented by respondent also goes against settled understandings under the patent laws. According to respondent, it is the written description in a specification, not the patent claims themselves, that must carry out "the function of distinguishing an invention from the prior art . . . ." Br. in Opp. 18. But respondent has matters just backwards. It is the *claims*, not the written description, that "define the invention for the purpose of applying the conditions of patentability (eligible subject matter, originality, novelty, utility, and nonobviousness), the statutory bars, and the disclosure requirement." D. Chisum, 3 *Patents* § 8.01 at 8-3 (1998 ed.). *See* 35 U.S.C. § 112, ¶ 2 (claims must specify what "the applicant regards as his invention"). This Court has so stated, in fact, observing that, in applying the Section 103 standard of nonobviousness, it is necessary to determine the "differences between the prior art *and the claims at issue*." *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (emphasis added). *See generally Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384, 1388 (1996) ("[t]he claim define[s] the scope of a patent grant") (internal quotes omitted); *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 117 S. Ct. 1040, 1049 (1997) (noting "definitional and public-notice functions of the statutory claiming require-

ment"). Each *claim* must define an invention that is distinguishable from the prior art, while the written description in the specification must enable the making and using of the invention defined in the claim.

Respondent compounds his mistake by asserting that "historically, a major function of the written-description requirement has been to 'distinguish [the invention] *from all other things before known.*'" Br. in Opp. 19 (quoting Patent Act of 1793 § 3, 1 Stat. 318) (emphasis added by respondent). As we noted in the petition, however, the requirement that the written description distinguish the invention "from all other things before known" was dropped from the Patent Act in 1836, at the time that the Act first required the inventor to specify the subject matter of his invention. (The 1870 Act subsequently required an inventor to "claim" his invention.) From that point on, the purpose of the written description requirement was simply to provide a written description of the invention, along with the manner of making and using it, that was sufficient to allow a person skilled in the art to make and use it. The belated efforts by respondent to engraft an additional requirement are thus no more supportable than the efforts by the Federal Circuit.

Respondent asserts, however, that our reading of the statute makes the parenthetical phrase "and of the manner and process of making and using it" into mere surplusage. To begin with, this assertion is dubious: it seems entirely natural for Congress to require an inventor to describe both the end product of his work ("the invention") and the steps necessary to create and employ it ("the manner and process of making and using it") in such terms as to allow a skilled artisan to make and use it. Indeed, if the inventor were not required to describe the manner of making and using the invention, it might be argued that he had satisfied his obligation under Section 112, ¶ 1 merely by describing the invention itself and forcing the artisan to undertake the possible but burdensome task of working backwards to determine the manner of making it. In

any event, however, even if there were some unnecessary wording, it is far more reasonable to think that Congress engaged in the not uncommon practice of repeating itself than to assume that Congress consciously intended the modifying language following the parenthetical to apply *only* to it, and not to the words "the invention." There is no known grammatical construction that can lead to that illogical result.[2]

3. The attempt by respondent to minimize the significance of *Pfaff* is also unavailing. In essence, respondent argues that the decision in *Pfaff* sheds no light on the issue here because neither the on-sale bar nor the "ready for patenting" standard in that case has anything to do with "distinctions over prior art" (Br. in Opp. 22) or "advancing the prior art" (Br. in Opp. 22). The short answer to this argument is that the written description requirement likewise is not concerned with distinctions over prior art. *See* pages 5-6 *supra*. More significant, however, is the light that *Pfaff* does shed on a central question in this case: when an inventor may be regarded as having a complete conception of his invention.

On that point *Pfaff* has much of importance to say. In particular, the Court in *Pfaff* observed that "[t]he word 'invention' must refer to a concept that is complete, rather

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[2] Respondent does little to defend the holding below that the written description must "necssarily" or "unambiguously" show possession of the invention (assuming that the "possession" requirement is valid). Although he says that this standard is "more precise" than the "reasonably conveys" standard, there is nothing more exact or easier to apply about the "necessarily" standard; it is simply narrower. And, in arguing that the "necessarily" standard would not resolve all doubts against the inventor, as its terms would suggest, respondent offers the reassurance that "as long as the inventor, expert in his or her own field, would fully and accurately describe the invention, the disclosure would *likely* be found sufficient." Br. in Opp. 14 n.7 (emphasis added). This case is a perfect example of the uncertainty caused by a requirement that a "full[]" and "accurate[]" description of the invention would likely, but not necessarily, be enough to satisfy.

than merely one that is 'substantially complete.'" 119 S. Ct. at 311. The Court then noted that, while reduction to practice is typically "the best evidence that an invention is complete," *id.*, it is not the only possible evidence: "one can prove that an invention is complete and ready for patenting before it has actually been reduced to practice." *Id.* Finally, the Court held that—to prove that an invention is ready for patenting—it would be sufficient that "the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention." *Id.* at 312.[3] Taken together, these observations plainly lead to the conclusion that a description enabling the making and using of an invention also establishes that the inventor has a complete conception of his invention.

That is precisely the point that we are making here: that an inventor providing an enabling description of his invention is properly deemed to be in possession of the invention at that time. That being so, it is wholly anomalous for the Federal Circuit to hold that an inventor must meet *both* an enablement requirement *and* a "separate and distinct" possession-of-the-invention requirement (which is not satisfied by proof of enablement). It is this second requirement, ungrounded in the statute, that confronts patent applicants with the task of drafting specifications to satisfy a largely standardless inquiry and leads to the sort of *ad hoc* judgments admitted by respondent to be part and parcel of the possession-of-the-invention legacy. *See* Br. in

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[3] The Court said that the condition (that "the invention must be ready for patenting," 119 S. Ct. at 312) "may be satisfied in at least two ways." *Id.* Respondent now argues (Br. in Opp. 22) that use of the term "may be satisfied" indicates that the condition might *not* be satisfied in the specified ways. This fanciful reading is contradicted by the very next sentence in *Pfaff*, which states that the condition had been met in that case "because the drawings Pfaff sent to the manufacturer before the critical date fully disclosed the invention." *Id.* By the same token, a full, enabling disclosure is enough to satisfy the written description requirement of Section 112, ¶ 1.

Opp. 24. The law thus should be clarified to make clear that proof of enablement alone is enough to satisfy the written description obligations of Section 112, ¶ 1.

4. In order to diminish the importance of this case, respondent claims that it "involve[s] substantial, dispositive factual findings by the Board . . . ." Br. in Opp. 23. But the only "dispositive" findings of the Board were directed to the wrong question: whether, in addition to showing enablement, petitioner had demonstrated possession of the invention. If a showing of enablement is enough to satisfy Section 112, ¶ 1—as we contend that it is (along, of course, with a disclosure of the "best mode")—then the findings of the Board with respect to the erroneous additional requirement are wholly beside the point.[4]

Respondent also suggests that petitioner may be estopped from demonstrating that his written description enabled the making and using of a single chip computer. But this argument is a red herring. The Patent and Trademark Office, in issuing his patent, necessarily accepted that the written description submitted by petitioner did enable the making and using of a single chip computer, and the Board *rejected* the argument that an earlier decision estopped petitioner from demonstrating that this conclusion was correct.[5] Although reversal of the decision

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[4] On one factual point, we note that, while respondent asserts that petitioner's 1977 application included a more comprehensive description of a single chip computer than Claim 40 in the 1970 application, the language is, in fact, conspicuously similar. Compare Br. in Opp. 5 (quoting Claim 40) with Br. in Opp. 7-8 (quoting 1977 application). It is undisputed that the 1977 language met the written description requirement, even as applied by the Federal Circuit.

[5] Although respondent twice seeks to obscure the fact, *see* Br. in Opp. 12 n.6 ("Board . . . did not reach a consensus"); Br. in Opp. 25 ("decision . . . which divided the Board"), the Board held, by a 2-1 majority, that petitioner was not estopped by an earlier decision, *In re Hyatt*, No. 87-1597 (Fed. Cir. June 9, 1988) (un-

below will not assure that petitioner will ultimately prevail, it will assure that his right to a patent is not defeated, as it currently has been, on grounds that Congress did not provide for in the statute.

This case is thus of considerable importance. There is no reason to force patent applicants to satisfy a newly-invented requirement for patentability that has no legitimate statutory moorings and no sufficient, or even discernible, justification. The possession-of-the-invention requirement imposed by the Federal Circuit is just such a requirement, and it should not be allowed to stand without review by this Court.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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published opinion), from establishing enablement before the Patent and Trademark Office. Pet. App. 40a-50a.